

**Neifeld Docket No:** CAT/34-SCRO-US

Application/Patent No: 08/873,974

USPTO CONFIRMATION NO: 2461

File/Issue Date: 6/12/1997, CPA FILED AUGUST 17, 1999, PARENT FILED

Inventor/Title: SCROGGIE/SYSTEM AND METHOD FOR

DISTRIBUTING INFORMATION THROUGH COOPERATIVE COMMUNICATION

NETWORK SITES

Examiner/ArtUnit: ROBINSON/3628

ASSISTANT COMMISSION FOR PATENTS

WASHINGTON, D.C. 20231

37 CFR 41.37 APPEAL BRIEF IN RESPONSE TO NON FINAL OFFICE ACTION,

REOPENING PROSECUTION AFTER A DECISION ON APPEAL REVERSING

REJECTIONS OF ALL CLAIMS

SIR:

In response to the non final office action dated 5/23/2008 reopening prosecution after a decision on appeal reversing all prior rejections, the applicants appeals. Appeal after a second or subsequent office action rejecting claims is authorized by statute, case law, and rule. See 35 USC 134(a); Ex parte Lemoine, 46 USPQ2d 1420 (PTOBPAI 1994)(precedential decision of an expanded panel); and 37 CFR 41.31(a)(1).

The issuance of the office action was misguided; there is no basis for the rejections based upon Jovicic. Group director Coggins signed off on reopening prosecution. However, it is

inconceivable to the undersigned that Group director Coggins actually reviewed and approved the office action. The panel should note that her authorization to reopen prosecution appears on page 2 of the office action, before any rejections. The undersigned is separately sending a letter to the Director complaining of the procedural failures that were supposed to be imposed by requiring group director authorization to reopen prosecution after a BPAI reversal, resulting in allowing the office action appealed from be entered.

Group director Wynn Coggins signature does appear *below* the assertion in item 2 in the office action that "Jovicic, Smolen, Perkowski" were newly discovered. However, that statement is also wrong. Jovicic, which is the primary reference relied upon in the rejections of the independent claims, was filed 12/16/2004 by the applicant in an IDS, as reference U-3.

## Table of Contents

I.	<b>37 CFR 41.41(a)</b> .....	<u>7</u>
II.	<b>37 CFR 41.41(b)</b> .....	<u>7</u>
III.	<b>37 CFR 41.37(c)</b> .....	<u>7</u>
1.	37 CFR 41.37(c)(1)(i) .....	<u>7</u>
2.	37 CFR 41.37(c)(1)(ii) .....	<u>7</u>
3.	37 CFR 41.37(c)(1)(iii) .....	<u>8</u>
4.	37 CFR 41.37(c)(1)(iv) .....	<u>8</u>
5.	37 CFR 41.37(c)(1)(v) .....	<u>9</u>
6.	37 CFR 41.37(c)(1)(vi) .....	<u>15</u>
7.1	Whether the rejections of "Claims 50-51, 54-58, 60-61, 64-68, 70-71, 74-78, 80-81, 84-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007)." (office action page 3 lines 6-7) should be reversed. ....	<u>16</u>
7.2	Whether all rejections of "Claims 52, 62, 72, 82, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007), and further in view of Perkowski (US6,064,979)." (office action page 22 lines 16-19) should be reversed ....	<u>46</u>
7.3	Whether all rejections of "Claims 53, 63, 73, 83, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007), and further in view of Perkowski (US 6,064,979), and further in view of Smolen (US Patent 5,915,243)"( office action page 26 lines 16-18) should be reversed ....	<u>51</u>
7.4	Whether all rejections of "Claims 59, 69, 79, 89, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007), and further in view of Smolen (US Patent 5,915,243)." (office action page 27 lines 10-12) should be reversed ....	<u>53</u>
8.	37 CFR 41.37(c)(1)(viii) .....	<u>53</u>
9.	37 CFR 41.37(c)(1)(ix) .....	<u>54</u>
10.	37 CFR 41.37(c)(1)(x) .....	<u>55</u>
IV.	<b>37 CFR 41.37(c)(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.</b> .....	<u>55</u>
V.	<b>37 CFR 41.37(d) - Compliance with 37 CFR 41.37(c)</b> .....	<u>55</u>
VI.	<b>37 CFR 41.37(e) - Time Periods Extendable</b> .....	<u>55</u>

I. **37 CFR 41.41(a)**

(a)(1) - The brief is filed within 2 months of the notice of appeal.

(a)(2) - The brief is accompanied by the brief fee in addition to the notice of appeal and the notice of appeal fee.

II. **37 CFR 41.41(b)**

(b) - The appeal does not stand dismissed because the requisite fees have been paid.

III. **37 CFR 41.37(c)**

The brief contains the items noted in (c)(1)(i) to (c)(1)(x) "under appropriate headings and in the order indicated". See sections III.1 to III.10 below.

1. **37 CFR 41.37(c)(1)(i) - Real Party in Interest - A statement identifying by name the real party in interest**

The real party in interest is Catalina Marketing Catalina Marketing Corporation, a Delaware corporation.

2. **37 CFR 41.37(c)(1)(ii) - Related Appeals and Interferences - A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section**

A prior decision in this case having BPAI docket number 2004-1267 was mailed in this application on July 29, 2004. A copy of that decision is attachment 1.

A prior decision in this case having BPAI docket number 2004-1267 on request for rehearing was mailed September 30, 2004. A copy of that decision is attachment 2.

A prior final decision in this case having BPAI docket number 2006-2100 was mailed 1/31/2008. A copy of that decision is attachment 3.

There was a prior appeal to the CAFC in this case, but it was remanded without decision since the BPAI decision appealed from was not final.

The related 09/505,632 was the subject of a prior appeal to the BPAI having BPAI docket 2002-0329. A decision in BPAI docket 2002-032 was mailed October 27, 2003. A copy of that decision is attached as Attachment 4.

An appeal is pending in related case attorney docket number CAT/34-SCRO-CCP; application number 09/505,632; docketed at the BPAI in a paper dated 7/29/2008 as docket No. 2008-4711. No decision has been rendered on that appeal.

3. **37 CFR 41.37(c)(1)(iii) - Status of Claims - A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.**

Claims 50-89 are pending and rejected. The rejections of all of claims 50-89 are being appealed.

4. **37 CFR 41.37(c)(1)(iv) - Status of Amendments Subsequent to Final**

## **Rejection**

There is no amendment filed subsequent to a final rejection that is not entered. There is final rejection, the office action appealed from is a non final office action.

5. **37 CFR 41.37(c)(1)(v) - Summary of Claimed Subject Matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.**

The claims are a concise explanation of the subject matter defined thereby.

Independent claims 50, 60, and 70 are their concise explanation. Reference therein to support in the disclosure by page and line number of the specification and drawing and reference characters of the figures follows.

### **INDEPENDENT CLAIMS 50, 60, 70, 80**

50. (Previously Presented) A system for distributing product incentives to consumers over a communication network (page 3 line 1-4, page 14 line 24), comprising:

a cooperative network site (page 3 line 8; Fig. 1, SMO web server 14) configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a

manufacturer (page 3 lines 22-23; Fig. 1 manufacture offers 16) and (ii) retailer incentives to purchase one of a product and a service offered by a retailer (page 3 lines 8-9; Fig. 1 retailer specials 18);

at least one of a manufacturer network site (page 3 lines 13; Fig. 1 MFG WEB SITES 10) and a retailer network site (page 3 lines 19-20; Fig. 1 RETAILER WEB SITES 12) coupled to said cooperative network site via said communication network; and

a consumer computer ("consumer communication node", "personal computer", page 8 lines 11; Fig. 1, PERSONAL PAGE 22) coupled to one of said manufacturer network site and retailer network site via said communication network (page 3 lines 20-21, 27-28),

wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site (page 3 lines 9-14).

60. (Previously Presented) A process for distributing product incentives to consumers over a communication network (page 3 line 1-4, page 14 line 24), comprising:

storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer (page 3 lines 22-23; Fig. 1 manufacture offers 16) and (ii) retailer incentives to purchase one of a product and a service offered by a retailer (page 3 lines 8-9; Fig. 1 retailer specials 18) at a cooperative network site (page 3 line 8; Fig. 1, SMO web server 14);

coupling at least one of a manufacturer network site (page 3 lines 13; Fig. 1 MFG WEB SITES 10) and a retailer network site (page 3 lines 19-20; Fig. 1 RETAILER WEB SITES 12) to said cooperative network site via said communication network;

coupling a consumer computer ("consumer communication node", "personal computer", page 8 lines 11; Fig. 1, PERSONAL PAGE 22) to one of said manufacturer network site and

retailer network site via said communication network; and

transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site (page 3 lines 9-14).

70. (Previously Presented) A system for distributing product incentives to consumers over a communication network (page 3 line 1-4, page 14 line 24), comprising:

means for storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer (page 3 lines 22-23; Fig. 1 manufacture offers 16) and (ii) retailer incentives to purchase one of a product and a service offered by a retailer (page 3 lines 8-9; Fig. 1 retailer specials 18) at a cooperative network site (page 3 line 8; Fig. 1, SMO web server 14);

means for coupling (page 3 line 1-4, page 14 line 24) at least one of a manufacturer network site (page 3 lines 13; Fig. 1 MFG WEB SITES 10) and a retailer network site (page 3 lines 19-20; Fig. 1 RETAILER WEB SITES 12) to said cooperative network site via said communication network;

means for coupling (page 3 line 1-4, page 14 line 24) a consumer computer to one of said manufacturer network site and retailer network site via said communication network; and

means for transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site (page 3 lines 9-14).

80. (Previously Presented) A computer program product comprising a computer storage medium having a computer program embedded in said computer storage medium for causing a computer to distribute product incentives to consumers over a

communication network (page 3 line 1-4, page 14 line 24), said computer program performing the steps of:

storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer (page 3 lines 22-23; Fig. 1 manufacture offers 16) and (ii) retailer incentives to purchase one of a product and a service offered by a retailer (page 3 lines 8-9; Fig. 1 retailer specials 18) at a cooperative network site (page 3 line 8; Fig. 1, SMO web server 14);

coupling at least one of a manufacturer network site (page 3 lines 13; Fig. 1 MFG WEB SITES 10) and a retailer network site (page 3 lines 19-20; Fig. 1 RETAILER WEB SITES 12) to said cooperative network site via said communication network;

coupling a consumer computer ("consumer communication node", "personal computer", page 8 lines 11; Fig. 1, PERSONAL PAGE 22) to one of said manufacturer network site and retailer network site via said communication network; and

transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site (page 3 lines 9-14).

#### **DEPENDENT CLAIMS 71-79 (MEANS RECITATIONS)**

71. (Previously Presented) The system of claim 70, further comprising:  
means for storing at said cooperative network site at least one of said manufacturer incentives and retailer incentives in a data base coupled thereto. (page 8 lines 18-21; Figure 1 items 16 and 18).

72. (Previously Presented) The system of claim 70, further comprising:  
means for transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said

consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site (page 3 lines 19-22, page 9 lines 17-29);

means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site (page 3 lines 23-26, page 9 line 28 through page 10 line 3); and

means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site (page 3 lines 24-26, page 9 line 28 through page 10 line 3).

73. (Previously Presented) The system of claim 72, further comprising:

means for transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site (page 9 lines 24-29).

74. (Previously Presented) The system of claim 70, further comprising:

means for transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site (page 10 lines 4-12);

means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site (page 3 lines 23-24); and

means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site (page 3 lines 24-26, page 10 lines 12-16).

75. (Previously Presented) The system of claim 70, further comprising:

means for transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site (page 11 line 28 through page 12 line 5);

means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site (page 3 lines 23-24);  
and

means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site (page 11 lines 8-27).

76. (Previously Presented) The system of claim 70, further comprising:

means for transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code (page 12 lines 6-20);

means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site (page 3 lines 23-24);  
and

means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site (page 12 line 29 through page 13 line 3).

77. (Previously Presented) The system of claim 76, further comprising:

means for basing said incentive data on said consumer specific data comprising a shopping history of said consumer (page 12 lines 15-20).

78. (Previously Presented) The system of claim 76, further comprising:

means for basing said incentive data on said consumer specific data comprising demographic data of said consumer (page 13 lines 8-19; page 14 lines 7-16).

79. (Previously Presented) The system of claim 76, further comprising:

means for basing said incentive data on said consumer specific data comprising customer profile data of said consumer (page 14 lines 12-16).

6. **37 CFR 41.37(c)(1)(vi) - A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed**

Whether the rejections of "Claims 50-51, 54-58, 60-61, 64-68, 70-71, 74-78, 80-81, 84-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007)." (office action page 3 lines 6-7) should be reversed.

Whether all rejections of "Claims 52, 62, 72, 82, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007), and further in view of Perkowski (US 6,064,979)." (office action page 22 lines 16-19) should be reversed.

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Whether all rejections of "Claims 59, 69, 79, 89, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007), and further in view of Smolen (US Patent 5,915,243)." (office action page 27 lines 10-12) should be reversed.

7. **37 CFR 41.37(c)(1)(vi) Argument - The contentions of appellant with respect**

**to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading**

The issuance of the office action was misguided; there is no basis for the rejections based upon Jovicic. Group director Coggins signed off on reopening prosecution. However, it is inconceivable to the undersigned that Group director Coggins actually reviewed and approved the office action. The panel should note that her authorization to reopen prosecution appears on page 2 of the office action, before any rejections. The undersigned is separately sending a letter to the Director complaining of the procedural failures that were supposed to be imposed by requiring group director authorization to reopen prosecution after a BPAI reversal, resulting in allowing the office action appealed from be entered.

Group director Wynn Coggins signature does appear *below* the assertion in item 2 in the office action that "Jovicic, Smolen, Perkowski" were newly discovered. However, that statement is also wrong. Jovicic, which is the primary reference relied upon in the rejections of the independent claims, was filed 12/16/2004 by the applicant in an IDS, as reference U-3.

- 7.1 Whether the rejections of "Claims 50-51, 54-58, 60-61, 64-68, 70-71, 74-78, 80-81, 84-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007)." (office action page 3 lines 6-7) should be reversed.**

#### 7.1.1. CLAIMS 50, 60, 70, AND 80

Claim 60 is representative of claims 50, 60, 70, and 80.

This application discloses, and we claim, communication from consumer, to retailer or manufacturer, and then, in response, communication of an incentive from cooperative network site to the consumer. In contrast, Jovicic discloses transmitting from the consumer to a coupon server, and then transmitting from the coupon server transmitting back to the consumer. In our claimed invention, *three network sites are involved in responsive communication*. In Jovicic, only two are involved in responsive communication. Note the "in response to" in our claim 60.

The examiner makes two fundamental errors.

First, the examiner makes an error in fact and law by asserting that claim 60's "coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network" corresponds to Jovicic Fig. 1 element 102. Office action page 8 line 15.

Second, the examiner makes additional errors of fact and law by concluding that claim 60's "transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site" would have been obvious, even though admittedly not disclosed by Jovicic.

#### 7.1.2 JOVICIC

Jovicic discloses a network including

- (1) user's computer 102,
- (2) a coupon server 124, and

(3) an internet coupon notification center (ICNC) 134. See, for example, abstract and Fig. 1.

Jovicic discloses that the user via the user computer 102, which Jovicic also calls the network node (see for example column 3 lines 39-43), initiates an online session with the coupon server 124 (col. 4 lines 17-23; col. 4 lines 10-13).

Jovicic discloses that, during that session, the user selects from coupon server 124 an electronic coupon (col. 4 lines 19-21; col. 3 lines 47-50). Jovicic discloses that, in response, the user computer 102 receives from coupon server 124 the selected coupon (column 3 lines 27-28).

In some more detail, Jovicic discloses that coupon server 124 transmits to the user computer 102 coupon selections (col. 3 lines 47-50), generates coupon IDs (col. 4 lines 10-13) for the coupons, and transmits the requested coupons to the user's computer 102 (col. 4 lines 13-16). Jovicic also discloses that the coupon server 124 provides notifications of those coupons including their IDs to the ICNC 134 (column 3 lines 34-38).

Jovicic discloses that the ICNC 134 (1) stores notifications sent by the coupon server to the ICNC, of coupons transmitted by the coupon server to the user (Jovicic col. 4 lines 39-41), and (2) stores notifications sent to the ICNC, of coupons redeemed at stores (col. 4 lines 50-54). Jovicic (column 3 lines 34-38) discloses that the ICNC 134 compares notifications of coupon redemption (including coupon data) against the copies of coupons in its generation database 136 to confirm validity of the coupon redemption data.

Jovicic discloses that the ICNC provides to coupon server 124 data "regarding the discount value of the coupon, number of coupons available, and coupon specifications" for on particular category of coupons (column 6 lines 24-39).

Jovicic (column 10 lines 50-54) discloses that an ICNC can either connect to Coupon Server 124 over a public network, or the ICNC can be contained in Coupon Server 124.

What Jovicic does not disclose is just as important.

Jovicic does not disclose that the user computer 102 communicates with the ICNC 134.

Jovicic does not disclose that the ICNC responds to the user's communication with the coupon server by sending the user computer 102 a coupon.

Jovicic does not disclose that the coupon server 124 responds to a user's communication with the ICNC to send the user a coupon.

Jovicic does not disclose responsive communication involving three network nodes.

Jovicic consistently defines coupling to mean a connection resulting in communication.

See for example:

Jovicic's claim 1, "a display coupled to a control processing unit for displaying"; "a user input device coupled to said central processing unit to permit a user to make an on-line selection"; "said Internet Coupon Server being coupled to the Internet Coupon Notification Center"; (noting the specification discloses that those two nodes communicate with one another)

Jovicic's Brief Summary of the Invention section, "The invention thus comprises an electronic coupon communication system, comprising a network node for selecting, receiving and printing electronic coupons over a public computer network such as the Internet, the node including a display coupled to a control processing unit for displaying at least one electronic coupon"; "a user input device coupled to the central processing unit to permit a user to make an on-line selection of one of a plurality of electronic coupons collectively stored in the Internet Coupon Server's memory"; "the Internet Coupon Server being coupled to the Internet Coupon Notification Center, ...[and], an Internet Coupon Notification Center Gateway for enabling communication with the Internet Coupon Notification Center"; and

Jovicic's Description of the Preferred Embodiment section, "In addition, the computer 200 includes a central processing unit (CPU) 202 coupled to the I/O circuit 206 and a memory 204"; "A display monitor 214 is shown coupled to the I/O circuit 206 and issued to display images generated by CPU 202 in accordance with the present invention."; "computer 200

preferably includes one or more input devices which are coupled to the I/O circuit 206 for receiving input from a user."; "The computer 200 preferably includes one or more output devices coupled to the I/O circuit 206 for presenting information to the user of the computer."; "As shown in FIG. 1, the Internet node 102 is coupled to an Internet Coupon Server 124 via Internet 122."; and "In the preferred embodiment of the present invention, the redemption center's computing device is coupled with Internet Coupon Server's ICNC gateway 908 through communication network, such as electronic data interchange network, public computer network or wireless network".

### **7.1.3 THIS APPLICATION - "manufacturer network site" and "retailer network site".**

Claim construction is based upon the words of the claims, the specification, and relevant extrinsic evidence. Cf. Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., \_\_\_ F.3d \_\_\_, \_\_\_, \_\_\_ USPQ2d \_\_\_, \_\_\_ (Fed. Cir. 2003).

This application discloses Internet Web sites run by a manufacturer or a retailer, such that the manufacturer web site discloses information related to products manufactured by the manufacturer and distributed to retailers and the retailer web site discloses information relating to the retailer and products the retailer sells to the public. See the background section of this application, paragraphs 3 and 4. That is what claims in this application mean by reciting "manufacturer network site" and "retailer network site". In addition, this application discloses the cooperative network site and the inventive features claimed relating to the use of the cooperative site, at least one of the manufacturer network site" and "retailer network site", in connection with communications with a user. In fact, this application also states, in the Summary of the Invention section, "viewing by the consumer" [published paragraph [0013], in

the Detailed Description section that the consumer using their Web Browser (published paragraph [0025]).

Further, the abstract ties "site" to web site, stating "At a manufacturer site, the consumer can obtain a list of local retailers carrying the manufacturer offers and can then select from among the offers and receive complete details of the selected offers. At a retailer site, the consumer can obtain a list of manufacturer offers available at the retailer stores in the consumer's area, and can then select from among the available offers and receive their complete details." This is because site refers obviously to other than a physical store. The background section indicates that consumers obtain coupons from web sites, and the remainder of the specification discusses the consumer using viewing information and graphics, which generally requires a web browser program.

Thus, the claimed "manufacturer network site" and "retailer network site" define network sites that operate, at least, web server software.

#### **7.1.4 COMPARING JOVICIC TO CLAIM 60**

Claim 60 reads:

60. (Previously Presented) A process for distributing product incentives to consumers over a communication network, comprising:

storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer at a cooperative network site;

coupling at least one of a manufacturer network site and a retailer network site to said cooperative network site via said communication network;

coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network; and

transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. [Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 466-67 (1966).]

A holding of obviousness requires, at least, some rational underpinning explaining why one skilled in the art would have modified or combined to achieved the claimed subject matter, such as a teaching suggesting the modification or combination. KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 167 L. Ed. 2d 705, 2007 U.S. LEXIS 4745 (U.S., 2007).

The Patent and Trademark Office has the burden of showing a prima facie case of obviousness. In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993); In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In this case, there is no prima facie case because the assertions of element correspondence is wrong, and there is rational underpinning explaining why one skilled in the art would have modified or combined to achieved the claimed subject matter.

#### **7.1.5 CLAIM 60's "coupling a consumer computer to one of said manufacturer**

**network site and retailer network site via said communication network"**

The examiner corresponds Jovicic's Fig. 1 user computer 102 to the claimed consumer computer. However the examiner fails to explain how Jovicic discloses the claimed coupling to a manufacturer or retailer network site, in "coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network."

Jovicic Fig. 1 shows user computer 102 with 2 way arrows only connecting via Internet 122 to Internet coupon server 124. This indicates that Fig. 1 discloses coupling user computer 102 to Internet coupon server 124. Fig. 1 does not suggest coupling user computer 102 to any other element.

Fig. 1 does not suggest communications between user computer 102 and redemption center 142. Moreover, Jovicic does not indicate that user computer 102 communicates with redemption center 142. Furthermore, Jovicic does not suggest that redemption center 142 is a retailer or wholesaler network site.

In the claims, coupling means communicating or storing of information for communicating. That is what one skilled in that art would understand, and use of the term coupling, as evidenced by Jovicic, meant that.

Jovicic does not mean, by coupling, that two computers are merely both able to access the Internet. Otherwise, statements in Jovicic like that at col. 50-52, specifying that the Internet coupon server is coupled to the Internet coupon notification center, and at col. 6 lines 4-5, would be meaningless. What Jovicic means by coupled is a communication channel such as storage of network identifications and corresponding code used for transmission of information. Thus, Jovicic discloses that the coupon server and the ICNC are coupled, and that those two network nodes communicate with one another, but Jovicic does not disclose that the user computer and the ICNC are coupled, and does not disclose (or suggest) that the user computer and the ICNC

communicate with one another.

Internet protocol, by definition, is via packet with embedded destination address (URL), and is stateless, in the sense that there is no physical line or contiguous electrical line carrying voltage between computers transmitting packets. Thus, computers capable of accessing the Internet are all capable of communicating with one another, but coupled means more than that, in the sense meant by Jovicic, our specification, and our claims, to define actual communication with, or at a minimum storage of the data necessary to perform actual communication, such as IP address or domain name of the other network node.

Furthermore, it is clear from the specification of this application and the other limitations of claim 60 that the claimed "coupling" requires communication. Otherwise, the claimed "coupling" steps would be redundant in view of the fact that claim 50/60 (see claim 50 which contains the structure limitation, claim 60 is the corresponding process) the preamble, of claims 50/60 recite "a communication network". This is because a communication network in the computer arts means a system of two or more computers terminals, and communication devices enabling communication there between. Thus, the preamble of claim 50/60 means the network nodes (or steps using network nodes in claim 60) are already capable of communicating with one another. Thus, the claimed "coupling" must provide additional limitations, by basic cannons of claim construction that words in a claim are assumed to further limit, and otherwise, the claimed "coupling" steps or structure would be redundant.

Finally, only coupling meaning communicating or storing of information necessary for communication (IP address, domain name, URL, or the like) makes sense in view of the specification of this application. See for example, the first four paragraphs of the Summary of the Invention section of our specification which refer to the consumer "connecting to, or simply viewing, a selected server site", in order to receive "a query from a consumer logged in to a network site of" a manufacturer or retailer.

In summary, Jovicic does not disclose or suggest his user computer communicating with an ICNC. Thus, Jovicic does not disclose claim 60's "coupling a consumer computer" to an ICNC network site, which the examiner corresponds with a claim 60's retailer or manufacturer network site.

Nothing in Jovicic or available to one skilled in the art at the time of this invention would suggest the claimed coupling. Accordingly, the rejection of claim 60 is improper and should be reversed.

**7.1.6 CLAIM 60's "transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site"**

The examiner states (office action page 9 lines 5-18) the following:

Jovicic et al does not specifically disclose that the consumer requests coupons from the retailer/manufacturer and then sending the coupons to the consumer from the cooperative network site, however does disclose that the consumer requests and receives the actual coupons from the cooperative network site, and also teaches that the retailer provides the coupon information to the cooperative network site since the coupon generation database specifies coupons that are made available in Col. 6, lines 34-41 and Col. II , lines 44-48. In addition, Jovicic teaches that the ICNC could be coupled with the Internet Coupon Server in Col. 10, lines 50-58. Therefore, the teachings of Jovicic would suggest that the

coupons may also be generated/sent to customer from the ICNC/internet Coupon Server combined unit.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the consumer's request to be from one of said manufacturer network site and retailer network site with the motivation of allowing the consumer the option of selecting either manufacture's coupons or retailer's coupons.

In response, its is unclear what the examiner is asserting.

The appellant agrees that "Jovicic et al does not specifically disclose that the consumer requests coupons from the retailer/manufacturer and then sending the coupons to the consumer from the cooperative network site."

The appellant agrees that Jovicic "does disclose that the consumer requests and receives the actual coupons from the cooperative network site."

The appellant does not agree with the assertion that Jovicic "teaches that the retailer provides the coupon information to the cooperative network." What Jovicic teaches is that an ICNC provides the coupon information to the cooperative network.

The appellant strongly disagrees with the assertion that "Jovicic teaches that the ICNC could be coupled with the Internet Coupon Server in Col. 10, lines 50-58." That statement is factually wrong. In fact, Jovicic column 10 lines 50-58 state in relevant part that ICNC "could be *contained in* the Internet Coupon Server 124 itself." Thus, Jovicic column 10 lines 50-58 discloses an alternate embodiment in which the ICNC is software residing in the same computer as the coupon server. In contrast, claim 60 recites separate network sites, including (1) at least one of a manufacturer network site and a retailer network site and (2) a cooperative network.

The appellant agrees with the statement that "Therefore, the teachings of Jovicic would

suggest that the coupons may also be generated/sent to customer from the ICNC/internet Coupon Server combined unit." However, such a unit is a single network site, and therefore fails to correspond to claim 60's two separate network sites, one for the cooperate network site, and one for the retailer or manufacture network site. An embodiment with a single network site providing coupon serving and ICNC functions cannot correspond to claim 60's limitations.

Finally, the appellant strongly disagrees with the assertion "It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the consumer's request to be from one of said manufacturer network site and retailer network site with the motivation of allowing the consumer the option of selecting either manufacture's coupons or retailer's coupons".

As discussed in detail above, but for this conclusion, there is no basis for the rejection of claim 60 in view of Jovicic. The reasons why this conclusion is error follow.

First, this assertion is a mere conclusion, unsupported by evidence. Jovicic does not suggest that there desire to " allow[] the consumer the option of selecting either manufacture's coupons or retailer's coupons".

Second, even assuming the motivation exists to " allow[] the consumer the option of selecting either manufacture's coupons or retailer's coupons", the only reasonable modification of Jovicic's system resulting from that motivation would be to configure Jovicic's coupon server to allow the users to select between coupons from manufacturer's and coupons from retailers. Therefore, the existence of the motivation would not result in claim 60.

Third, even assuming arguendo that to " allow[] the consumer the option of selecting either manufacture's coupons or retailer's coupons", and also motivation to enable "the consumer's request to be from one of said manufacturer network site and retailer network site", which there is not, the only obvious approach would be for that retailer or manufacturer network site to send the coupon to the consumer.

Finally, even assuming arguendo that motivation existed to have the retailer or manufacturer sites communicate with the consumers, even with that, there is still no suggestion for the claimed "in response to" limitations. For example, assuming arguendo that Jovicic's ICNCs received coupon requests from consumers, and Jovicic's coupon server was to provide the resulting coupons, the only reasonable way to do that is the way Jovicic now discloses that its ICNCs provides coupon instructions to Jovicic's coupon server. Specifically, which in advance of the coupon requests. Jovicic's ICNCs provide the coupon server coupons (or instructions as to a number and type of coupon that the coupon server is allowed to send to consumers) periodically or aperiodically, not in response to a request from a consumer. Instead, and in contrast, claim 60 defines coupons "in response to".

#### **7.1.7 CLAIM 60's " one of said manufacturer network site and retailer network site"**

The examiner corresponds Jovicic's ICNC to the claimed manufacturer web site or to the claimed retailer web site. The examiner relies upon column 2 lines 65-67. Office action page 3 lines 13-15. The examiner is wrong.

All that column 2 lines 65-67 state is that Jovicic ICNC stores coupon data. In fact, Jovicic discloses that its ICNC is designed to communicate data to Jovicic's coupon server to provide coupon data specification (date range, number of coupons authorized, and details of coupon offer), not to serve web pages to a consumer computer so that a consumer can view and make sense of data.

Jovicic's ICNC theoretically could be implemented to provide data in html format (which is the type of data a web browser can render into graphical images so a user can understand the data), but as any programmer would tell you, that would be an incredibly stupid thing to do. This

is because it would require the coupon serve to parse HTML code to determine data contained therein. HTML code is not designed for parsing to determine data contained therein. HTML code is "loose" - - certain tags to not require closing elements making it difficult to parse into discrete data elements, and the data fields, per se, are not tagged with data definitions, as in XML tagging. Thus, no one would consider Jovicic's ICNC to be a web server, and modification of Jovicic's ICNC would not have been obvious, and the examiner has made such an assertion.

When read in light of our specification, which requires the claimed "retailer network site" and the claimed "manufacturer network site" to include at least function of web server software capable of responding to web browsing requests from computers operated by consumers. See section "7.1.3 THIS APPLICATION" herein above. Therefore, the claimed "manufacturer network site" and the claimed "retailer network site" cannot read upon Jovicic's ICNC. The examiner relies upon nothing besides Jovicic's ICNC to correspond to the claimed "retailer network site" and the claimed "manufacturer network site". The examiner makes no argument that these claimed elements would have otherwise been obvious.

For the reasons presented in the foregoing sub sections, Jovicic does not suggest claim 60. Claims 50, 60, 70, and 80 define corresponding limitations. Therefore, Jovicic does not disclose or suggest independent claims 50, 60, 70, and 80 or any of the dependent claims, for at least the reasons noted above for claim 60.

Issuance of the office action was mis guided.

#### **7.1.8 The Rejections of Claims 54, 64, 74, 84 Should Be Reversed 54-58, 64-68, 74-78, and 84-88**

Claim 64 is representative. It reads:

64. (Previously Presented) The process of claim 60, further

comprising:

transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

The examiner asserts that Jovicic discloses all of claim 64's limitations. The examiner is wrong.

**7.1.9 Claim 64's " transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site"**

The examiner asserts that Jovicic discloses the claimed "transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;". The examiner relies upon Jovicic column 10 line 46 to column 11 line 3, column 11 lines 8-12. Office action page 5 lines 3-10; page 9 line last line to page 10 line 11. The examiner is wrong.

Jovicic column 10 line 46 to column 11 line 3 disclose only that the "operational sequence" of the ICNC 134 and database fields. More specifically, that the ICNC may be a

separate network site, or may be contained in, Internet Coupon Server 124; and that ICNC stores a coupon redemption database 138, a coupon generation database 136,, a general message database 140, and that the ICNC performs functions of processing coupon redemption messages received from coupon server 124 including storing the coupon serial number and redemption center identification number. This passage does not disclose responding to a consumer query to the retailer site by transmitting a geographically limited list from a cooperative network site, as claimed.

Jovicic column 11 lines 8-12 disclose only that the ICNC 134 responds to receipt of a coupon generation message transmitted from the coupon server 124 by storing the message, including the coupon identification number and the user's identification number, in the coupon generation database 136. This passage does not disclose responding to a consumer query to the retailer site by transmitting a geographically limited list from a cooperative network site, as claimed.

There are no other passages from Jovicic upon which the examiner relies to assert that Jovicic discloses or suggests claim 64's transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;". The examiner makes no argument that this limitation would have been obvious in view of Jovicic. Accordingly, the rejection of claim 64 is improper for this additional reason and should be reversed.

Claims 54, 64, 74, and 84 have analogous limitations. Therefore, the rejections of claims 54, 64, 74, and 84 should be reversed for the additional reasons in this subsection.

#### **7.1.10 Claim 64's "transmitting by said consumer incentive selection data selected**

**from said incentive data to said cooperative network site via said retailer network site"**

The examiner asserts that Jovicic column 3 lines 47-50 and Fig. 1 element 122 disclose Claim 64's "transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site". Office action page 5 lines 13-17; page 10 lines 12-15. Jovicic column 3 lines 47-50 discloses a "a user input device coupled to the central processing unit to permit a user to make an on-line selection of one of a plurality of electronic coupons collectively stored in the Internet Coupon Server's memory." Jovicic identifies Fig. 1 element 122 as the Internet. Jovicic column 5 line 28. Fig. 1 shows the user computer 122 communicating via the Internet 122 with the Internet coupon server 124.

Just to clarify, the examiner's association, that the examiner is again corresponding the claimed "cooperative network site" with Jovicic's Internet Coupon Server 124, not with Jovicic's ICNC. Jovicic does not for example disclose the ICNC forwarding the user's incentive selection data to the coupon server 124. Vice versa!

There is nothing in column 3 lines 47-50 or Fig. 1 disclosing the user "transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site", as claimed. The examiner makes no argument that this limitation would have been obvious in view of Jovicic. Accordingly, the rejection of claim 64 is improper and should be reversed.

Claims 54, 64, 74, and 84 have analogous limitations. Therefore, the rejections of claims 54, 64, 74, and 84 should be reversed for the additional reasons in this subsection.

**7.1.11 Claim 64's "transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer**

**network site"**

The examiner asserts that Jovicic column 11 lines 8-12 discloses claim 64's "transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site". Office action page 5 lines 18-21; page 10 lines 17-21.

Jovicic column 11 lines 8-12 disclose only that the ICNC 134 responds to receipt of a coupon generation message transmitted from the coupon server 124 by storing the message, including the coupon identification number and the user's identification number, in the coupon generation database 136. This passage does not disclose responding to a consumer query to the retailer site by transmitting a geographically limited list from a cooperative network site, as claimed.

There are no other passages from Jovicic upon which the examiner relies to assert that Jovicic discloses or suggests claim 64's "transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site". The examiner makes no argument that this limitation would have been obvious in view of Jovicic. Accordingly, the rejection of claim 64 is improper and should be reversed.

Claims 54, 64, 74, and 84 have analogous limitations. Therefore, the rejections of claims 54, 64, 74, and 84 should be reversed for the additional reasons in this subsection.

**7.1.12 The Rejections of Claims 55, 65, 75, and 85 Should Be Reversed**

Claim 65 is representative. It reads:

65. (Previously Presented) The process of claim 60, further comprising:

transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

The specification (as published) of this application contains the following description of the claimed "consumer personal page":

[0020] FIG. 6 is a block diagram showing a menu structure presented to a consumer using a personal page feature; and [Specification page 7 lines 9-10.]

[0026] If the consumer logs in to a retailer site 12, a similar dialog takes place, but may also use the concept of a "personal page" for the consumer. The personal page, indicated diagrammatically at 22, is a consumer-specific profile that the consumer may optionally provide at the SMO server site 14, either by logging in directly to the SMO server or by logging in indirectly through a retailer site 12. In the personal page, the consumer list various shopping preferences, which permit the SMO server 14 to provide manufacturer offers that are more specific to those preferences. In the illustrative dialog shown in FIG. 1, the consumer first logs in to his or her personal page through the retailer site 12 and requests manufacturer offers. The SMO server 14 delivers a list of targeted or non-targeted manufacturer

offers to the consumer, through the retailer site 12. The consumer selects from among the manufacturer offers, and the SMO servers delivers details of the selected offers to the consumer through the retailer server site. A performance recap pertaining to the activity with respect to retailer specials, is periodically transmitted to appropriate manufacturers, as indicated at 24. [Specification page 7 lines 9-10.]

[0031] When a consumer agrees to the establishment of a personal page, he or she may access the page after logging in to a retailer site 12 or the cooperative site 14, using an appropriate password or other security feature, and will then encounter a menu structure similar to the one shown in FIG. 6. First an introductory page 100 is presented and the consumer will be offered multiple further choices on a displayed "tool bar," as indicated on the upper row of blocks in FIG. 6. Each tool bar button takes the consumer to a succession of functions, as indicated by the columns of blocks in the figure. The tool bar options include selecting from among product offers 102, selecting retailer specials 104, making a personal list of products 106, proceeding to "final checkout" 108, selecting one or more available recipes 110, and selecting product information 112. [Specification page 9 lines 3-16.]

[0033] As it pertains to the present invention, the personal page feature, presents the consumer with manufacturer offers and retailer specials that are personalized as a result of the consumer's having used the personal page to better define his or her shopping preferences. The lists of manufacturer offers and retailer specials may also be personalized as a result of the consumer's prior shopping activity. As

a result, the personal page allows the presentation of product offers and retailer specials to be focused on individual consumers, based on their shopping preferences expressed in the personal page or by prior shopping activity.

[Specification page 7 lines 9-10.]

[0036] The cooperative networking aspect of the invention is enhanced by use of the personal page feature made available to consumers who log in to the cooperative site 14 or to a retailer site 10. The personal page, which is a feature that is invoked only at the option of the consumer, provides a mechanism for the SMO server 14 to generate more focused or personalized manufacturer offers. Once a consumer consents to the establishment of a personal page by supplying requested personal, demographic or other information, the SMO server 14 maintains a database for the specific consumer, including the consumer's personal preferences for products, as expressed by the consumer when requested, or as indicated by the consumer's prior shopping activity. In accordance with this aspect of the present invention, a consumer who has logged in to the system is asked to supply a consumer id. or code used for in-store purchases. The consumer id. may be a check-cashing card number, or other form of identification that allows the system to access the consumer's purchasing history, and then select one or more manufacturer's offers based on some aspect of the consumer's prior shopping history. The selected offer or offers are transmitted to the consumer in response to a request for a list of manufacturer offers available at a particular retailer.

[Specification page 13 lines 4-19.]

Most relevant to the rejection is the definition "As it pertains to the present invention, the

personal page feature, presents the consumer with manufacturer offers and retailer specials that are personalized as a result of the consumer's having used the personal page to better define his or her shopping preferences. "

**7.1.13 Claim 65's "transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;"**

The examiner asserts that Jovicic column 3 lines 49-59 and column 4 lines 26-28 disclose claim 64s "transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;". Office action page 5 last line to page 6 line 8; page 10 last line to page 11 line 8. The examiner is wrong.

Jovicic column 3 lines 49-59 merely discloses the existence of a user input device, online selection of coupons, coupon server memory storing coupons, a Gateway, and an ICNC.

Jovicic column 4 lines 26-28 merely discloses transmitting a coupon to a user's computer.

Nothing in Jovicic discloses transmitting a personal page, much less transmitting such a page in the context of the process defined by claim 62's "transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;".

The examiner makes no argument that this limitation would have been obvious in view of

Jovicic. Claims 55, 65, 75, and 85 recite analogous limitations. Therefore, the argument in this subsection apply to claims 55, 65, 75, and 85. Accordingly, the rejections of claims 55, 65, 75, and 85 is improper for this additional reason and should be reversed.

**7.1.14 Claim 65's "transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site"**

The examiner assert that Jovicic column 3 lines 47-50 and Fig. 1 element 122 disclose claim 65's "transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site". Office action page 6 lines 9-13; page 11 lines 10-14. The examiner is wrong. Jovicic column 3 lines 47-50 discloses a "a user input device coupled to the central processing unit to permit a user to make an on-line selection of one of a plurality of electronic coupons collectively stored in the Internet Coupon Server's memory." Jovicic identifies Fig. 1 element 122 as the Internet. Jovicic column 5 line 28. Fig. 1 shows the user computer 122 communicating via the Internet 122 with the Internet coupon server 124.

Just to clarify the examiner's association, that the examiner is again corresponding the claimed "cooperative network site" with Jovicic's Internet Coupon Server 124, not with Jovicic's ICNC. Jovicic does not for example disclose the ICNC forwarding the user's incentive selection data to the coupon server 124. Vice versa!

There is nothing in column 3 lines 47-50 or Fig. 1 disclosing the user "transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site," as claimed. The examiner makes no argument that this limitation would have been obvious in view of Jovicic.

Claims 55, 65, 75, and 85 recite analogous limitations. Therefore, the argument in this subsection apply to claims 55, 65, 75, and 85. Accordingly, the rejections of claims 55, 65, 75, and 85 is improper for this additional reason and should be reversed.

**7.1.15 Claim 65's "transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site"**

The examiner assert that Jovicic column 11 lines 8-12 disclose claim 65's "transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site". Office action page 6 lines 15-18; page 11 lines 14-18. The examiner is wrong.

Jovicic column 11 lines 8-12 disclose only that the ICNC 134 responds to receipt of a coupon generation message transmitted from the coupon server 124 by storing the message, including the coupon identification number and the user's identification number, in the coupon generation database 136. This passage does not disclose responding to a consumer query to the retailer site by transmitting from the cooperative network site via said retailer site corresponding incentives.

There are no other passages from Jovicic upon which the examiner relies to assert that Jovicic discloses or suggests claim 65's "transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site". The examiner makes no argument that this limitation would have been obvious in view of Jovicic. Claims 55, 65, 75, and 85 recite analogous limitations. Therefore, the argument in this subsection apply to claims 55, 65, 75, and 85. Accordingly, the rejections of claims 55, 65, 75, and 85 is improper for this additional reason and should be reversed.

#### 7.1.16 The Rejections of Claims 56, 66, 76, and 86 Should Be Reversed

Claim 66 reads as follows.

66. (Previously Presented) The process of claim 60, further comprising:

transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

#### 7.1.17 Claim 66's "transmitting from said cooperative network site incentive data

**for manufacturer offers available at said retailer to said consumer via said**

**retailer network site, in response to said consumer transmitting an**

**identification code over said communication network from said retailer**

**network site, and basing said incentive data on consumer specific data of said**

**consumer associated with said identification code;"**

The examiner asserts claim 66's "transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer

network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code;" is disclosed by Jovicic. The examiner relies upon Jovicic column 4 lines 30-47. Office action page 6 line 20 to page 7 line 5; page 11 line 20 to page 12 line 5. The examiner is wrong.

Jovicic column 4 lines 30 to 47 disclose the method of Jovicic's invention, including the user selecting a coupon during an online session with the coupon server, the coupon server sending the coupon to the user, during the sessions, and arranging a coupon database update in response to the transmission of the coupon from the coupon server to the user; storing the user's identification number and the coupon serial number. This passage is vague on particulars since it is only a summary sections. Jovicic's detailed description (at Jovicic column 10 line 46 to column 11 line 3 , discussed herein below) clarifies that the coupon server sends the user's identification number and the coupon serial number to the ICNC for logging. This passage of Jovicic does not disclose "transmitting from said coupon server incentive data for manufacturer offers available at a retailer to a consumer via an ICNC (for a retailers product), in response to the consumer transmitting an identification code over said communication network from said ICNC, and basing said incentive data on consumer specific data of said consumer associated with said identification code;" In fact, Jovicic does not disclose consumer selections passing from the coupon server passing through an ICNC; or a coupon server basing incentive data on consumer specific data. Thus, Jovicic does not disclose the claimed "transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code;".

There are no other passages from Jovicic upon which the examiner relies to assert that

Jovicic discloses or suggests claim 66's "transmitting from said coupon server incentive data for manufacturer offers available at a retailer to a consumer via an ICNC (for a retailers product), in response to the consumer transmitting an identification code over said communication network from said ICNC, and basing said incentive data on consumer specific data of said consumer associated with said identification code;". The examiner makes no argument that this limitation would have been obvious in view of Jovicic.

Claims 56, 66, 76, and 86 recite analogous limitations. Therefore, the argument in this subsection apply to claims 56, 66, 76, and 86. Accordingly, the rejections of claims 56, 66, 76, and 86 are improper for this additional reason and should be reversed.

**7.1.18 Claim 66's "transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site"**

The examiner asserts that Claim 66's "transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site" is disclosed by Jovicic. The examiner relies upon Jovicic column 3 lines 47-50, Fig. 1 element 122. Office action page 6 lines 10-14; page 12 lines 6-10; page 21 lines 11-16. The examiner is wrong.

Jovicic column 3 lines 47-50 discloses a "a user input device coupled to the central processing unit to permit a user to make an on-line selection of one of a plurality of electronic coupons collectively stored in the Internet Coupon Server's memory." Jovicic identifies Fig. 1 element 122 as the Internet. Jovicic column 5 line 28. Fig. 1 shows the user computer 122 communicating via the Internet 122 with the Internet coupon server 124.

Just to clarify, the examiner's association, that the examiner is again corresponding the

claimed "cooperative network site" with Jovicic's Internet Coupon Server 124, not with Jovicic's ICNC. Jovicic does not for example disclose the ICNC forwarding the user's incentive selection data to the coupon server 124. Vice versa!

There is nothing in column 3 lines 47-50 or Fig. 1 disclosing the user "transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site," as claimed. The examiner makes no argument that this limitation would have been obvious in view of Jovicic. Accordingly, the rejection of claim 66 is improper and should be reversed.

There are no other passages from Jovicic upon which the examiner relies to assert that Jovicic discloses or suggests claim 66's "transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site". The examiner makes no argument that this limitation would have been obvious in view of Jovicic.

Claims 56, 66, 76, and 86 recite analogous limitations. Therefore, the argument in this subsection apply to claims 56, 66, 76, and 86. Accordingly, the rejections of claims 56, 66, 76, and 86 are improper for this additional reason and should be reversed.

#### **7.1.19 Claim 66's "transmitting from said cooperative network site**

**incentives corresponding to said selection data to said consumer via  
said retailer network site."**

The examiner asserts that Claim 66's "transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site." is disclosed by Jovicic. The examiner relies upon Jovicic column 11 lines 8-12. Office action page 7 lines 11-15; page 12 lines 11-15. The examiner is wrong.

Jovicic column 11 lines 8-12 disclose only that the ICNC 134 responds to receipt of a coupon generation message transmitted from the coupon server 124 by storing the message, including the coupon identification number and the user's identification number, in the coupon generation database 136. This passage does not disclose responding to consumer selections at the retailer site by transmitting "from said cooperative network site incentives ... via said retailer network site" incentives to the consumer.

There are no other passages from Jovicic upon which the examiner relies to assert that Jovicic discloses or suggests claim 66's "'transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.'" The examiner makes no argument that this limitation would have been obvious in view of Jovicic. Claims 56, 66, 76, and 86 recite analogous limitations. Therefore, the argument in this subsection apply to claims 56, 66, 76, and 86. Accordingly, the rejections of claims 56, 66, 76, and 86 are improper for this additional reason and should be reversed.

#### **7.1.20 The Rejections of Claims 57, 67, 77, and 87 Should Be Reversed**

Claim 67 reads as follows.

67. (Previously Presented) The process of claim 66, further comprising:  
basing said incentive data on said consumer specific data comprising a shopping history of said consumer.

The examiner asserts that Jovicic discloses claim 67's "basing said incentive data on said consumer specific data comprising a shopping history of said consumer.". The examiner relies upon Jovicic column 9 lines 10-37. Office action page 7 lines 17-20; page 16-19. The examiner

is wrong.

Jovicic column 9 lines 10-37 merely disclose logging and of redeemed coupons. The examiner makes no argument that this limitation would have been obvious in view of Jovicic.

Claims 57, 67, 77, and 87 recite analogous limitations. Therefore, the argument in this subsection apply to claims 57, 67, 77, and 87. Accordingly, the rejections of claims 57, 67, 77, and 87 are improper for this additional reason and should be reversed.

#### **7.1.21 The Rejections of Claims 58, 68, 78, and 88 Should Be Reversed**

Claim 68 read as follows.

68. (Previously Presented) The process of claim 66, further comprising:  
basing said incentive data on said consumer specific data comprising  
demographic data of said consumer.

The examiner asserts that Jovicic discloses claim 68's "basing said incentive data on said consumer specific data comprising demographic data of said consumer." The examiner relies upon Jovicic column 9 lines 10-37. The examiner is wrong.

Jovicic column 9 lines 10-37 merely disclose logging and of redeemed coupons. The examiner makes no argument that this limitation would have been obvious in view of Jovicic.

Claims 58, 68, 78, and 88 recite analogous limitations. Therefore, the argument in this subsection apply to claims 58, 68, 78, and 88. Accordingly, the rejections of claims 58, 68, 78, and 88 are improper for this additional reason and should be reversed.

Note for the record that Jovicic does disclose storing demographic information (column 10 lines 12-17) for the purpose of demographic research (column 11 lines 41-44).

**7.2 Whether all rejections of "Claims 52, 62, 72, 82, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007), and further in view of Perkowski (US6,064,979)." (office action page 22 lines 16-19) should be reversed.**

Item 5 in the office action rejects claims 52, 62, 72, and 82 under 35 USC 103 as obvious based upon Jovicic 5,855,007 and Perkowski, 6,064,979.

Claims 52, 62, 72, and 82 depend from claims 50, 60, 70, and 80. The rejection of claims 50, 60, 70, and 80 was improper. Therefore, these rejections are also improper.

In item 5, the examiner relies upon Perkowski only to suggest a list of retailers. The examiner relies upon Perkowski column 13 lines 32-37 and column 18 lines 15-31's disclosure relating to providing URLs of associated with products. Office action page 26 lines 5-11. Perkowski is not applied to cure the deficiencies in the examiner's correspondence of Jovicic to claim 62's limitations, noted herein below.

Claim 62 is representative. It reads:

62. (Previously Presented) The process of claim 60, further comprising:

transmitting from said cooperative network site a geographically limited list of retailers honoing incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site;

and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site.

#### **7.2.1 Query information flow, and response**

Claim 62 further defines: "transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site;" transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site; and transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site." This clarifies that there is a query from said consumer made over said communication network from said manufacturer network site" and a "response to [the] query" by the "cooperative network site." Jovicic does not disclose or suggest a query from the consumer forwarded by the manufacturer site (or to an ICNC). Thus, even if the panel is not convinced that coupling means communicating, claim 62 defines a specific query communication path, consumer, manufacturer, cooperative network site, and a response thereby from the cooperative network site, not discloses or suggested by Jovicic. For this additional reason, the rejections of claims 52, 62, 72, and 82 are improper and should be reversed.

#### **7.2.2 Further Erroneous Correspondence to Jovicic**

Moreover, the examiner's analysis corresponding Jovicic to limitations of claim 62 is also flawed.

**7.2.3 Claim 62's "transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site."**

The examiner alleges that Jovicic discloses claim 62's "transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site." Office action page 22 line 19 to page 23 line 10; and office action page 24 line 15 to page 25 line 8. In support, the examiner cites Jovicic:

column 9 lines 65 to column 10 line 17;

column 10 line 46 to column 11 line 3; and

column 11 lines 8-12.

These passages do not support the examiner's assertions.

Jovicic column 9 lines 65 to column 10 line 17 disclose only that Internet Coupon Server 124 requires a user log in process, and Internet Coupon Server 124 stores location information provided by the user when the user initiates a log in account. This passage does not disclose responding to a consumer query to the manufacturer site by transmitting a geographically limited list from a cooperative network site, as claimed.

Jovicic column 10 line 46 to column 11 line 3 disclose only that the "operational sequence" of the ICNC 134 and database fields. More specifically, that the ICNC may be a separate network site, or may be contained in, Internet Coupon Server 124; and that ICNC stores a coupon redemption database 138, a coupon generation database 136,, a general message

database 140, and that the ICNC performs functions of processing coupon redemption messages received from coupon server 124 including storing the coupon serial number and redemption center identification number. This passage does not disclose responding to a consumer query to the manufacturer site by transmitting a geographically limited list from a cooperative network site, as claimed.

Jovicic column 11 lines 8-12 disclose only that the ICNC 134 responds to receipt of a coupon generation message transmitted from the coupon server 124 by storing the message, including the coupon identification number and the user's identification number, in the coupon generation database 136. This passage does not disclose responding to a consumer query to the manufacturer site by transmitting a geographically limited list from a cooperative network site, as claimed.

There are no other passages from Jovicic upon which the examiner relies to assert that Jovicic discloses or suggests claim 62's "transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site;". The examiner does not rely upon Perkowski to disclose this limitation. The examiner makes no argument that this limitation would have been obvious in view of Jovicic and/or Perkowski. Accordingly, the rejection of claim 62 is improper and should be reversed.

**7.2.4 Claim 62's "transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site"**

The examiner alleges that Jovicic discloses "transmitting by said consumer incentive

selection data selected from said incentive data to said cooperative network site via said manufacturer network site." The examiner relies upon Jovicic column 3 lines 47-50, and Fig. 1 element 122. Office action page 23 lines 11-15; page 25 lines 9-13. Jovicic column 3 lines 47-50 discloses a "a user input device coupled to the central processing unit to permit a user to make an on-line selection of one of a plurality of electronic coupons collectively stored in the Internet Coupon Server's memory." Jovicic identifies Fig. 1 element 122 as the Internet. Jovicic column 5 line 28. Fig. 1 shows the user computer 122 communicating via the Internet 122 with the Internet coupon server 124.

Just to clarify the examiner's association, that the examiner is again corresponding the claimed "cooperative network site" with Jovicic's Internet Coupon Server 124, not with Jovicic's ICNC. Jovicic does not for example disclose the ICNC forwarding the user's incentive selection data to the coupon server 124. Vice versa!

There is nothing in column 3 lines 47-50 or Fig. 1 disclosing the user "transmitting ... data to said cooperative network site via said manufacturer network site," as claimed. The examiner does not rely upon Perkowski to disclose this limitation. The examiner makes no argument that this limitation would have been obvious in view of Jovicic and/or Perkowski. Accordingly, the rejection of claim 62 is improper and should be reversed.

**7.2.5 Claim 62's "transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site."**

The examiner alleges that Jovicic discloses "transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site." The examiner relies upon Jovicic column 11 lines 8-12. Office action page 23

lines 16-20; page 25 lines 14-18. All that Jovicic column 11 lines 8-12 discloses is the ICNC storing a message sent by the coupon server 124 indicating that a coupon had been sent to a user, by storing the coupon's serial number and the user's identification number. That passage does not disclose "transmitting from [the coupon server] incentives corresponding to said selection data to said consumer via said [ICNC]". Jovicic does not disclose the ICNC ever coupling to the user's computer 102. Thus, that passage does not disclose "transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site," as claimed. The examiner does not rely upon Perkowski to disclose this limitation. The examiner makes no argument that this limitation would have been obvious in view of Jovicic and/or Perkowski. Accordingly, the rejection of claim 62 is improper and should be reversed.

Claims 52, 62, 72, and 82 each contain limitations analogous to those discussed above for claim 62. Therefore, the rejections of claims 52, 62, 72, and 82 are all improper and should be reversed for the additional reasons discussed above solely for claim 62.

**7.3 Whether all rejections of "Claims 53, 63, 73, 83, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007), and further in view of Perkowski (US 6,064,979), and further in view of Smolen (US Patent 5,915,243)"( office action page 26 lines 16-18) should be reversed**

Item 6 in the office action rejects claims 53, 63, 73, and 83 under 35 USC 103 as obvious based upon Jovicic 5,855,007 and Perkowski, 6,064,979 and Smolen 5,915,243. In item 6, the examiner relies upon Smolen only to suggest transmission based upon postal code, citing Smolen column 4 lines 64-67.

Claims 53, 63, 73, and 83 depend from claims 50, 60, 70, and 80. The rejection of claims

50, 60, 70, and 80 was improper. Therefore, these rejections are also improper.

Claim 63 is representative. It reads:

63. (Previously Presented) The process of claim 62, further comprising:

transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site.

Claims 53, 63, 73, and 83 depend from claims 52, 62, 72, and 82, respectively. The rejection of claims 52, 62, 72, and 82 was improper. Therefore, these rejections are also improper.

The examiner admits that neither Jovicic nor Perkowski disclose claim 63's limitation. Office action page 26 lines 19-22. The examiner relies assertions respecting claim 53. However, as noted in the discussion of claim 53, nothing in Jovicic discloses or suggests a geographical limitation. Claims 53, 63, 73, 83 recite analogous limitations. Therefore, the rejections of claims 53, 63, 73, 83 are improper for this additional reason and should be reversed.

The examiner relies upon Smolen to disclose that "transmission takes place based upon postal code, citing Smolen column 4 lines 64-67. Office action page 27 lines 3-6. The examiner is wrong. Smolen column 4 lines 64-67 only indicates storage of user telephone numbers, if they are provided by the user. See column 4 lines 42-44.

None of the references disclose or suggest providing a postal code via a manufacture network site to a cooperative network site and then the transmitting from said cooperative network site said geographically limited list. The examiner provides no reasoning suggesting otherwise. Therefore, the rejections of claims 53, 63, 73, and 83 are improper for this additional

reason and should be reversed.

**7.4 Whether all rejections of "Claims 59, 69, 79, 89, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007), and further in view of Smolen (US Patent 5,915,243)." (office action page 27 lines 10-12) should be reversed**

Item 7 in the office action rejects claims 59, 69, 79, and 89 under 35 USC 103 as obvious based upon Jovicic 5,855,007 and Smolen 5,915,243.

Claims 59, 69, 79, and 89 depend from claims 50, 60, 70, and 80. The rejection of claims 50, 60, 70, and 80 was improper. Therefore, these rejections are also improper.

In item 7, the examiner relies upon Smolen only to suggest storage of a manufacturer or retailer incentive in a database, citing Smolen column 1 lines 5-7.

Claim 69 is representative. It reads:

69. (Previously Presented) The process of claim 66, further comprising:  
basing said incentive data on said consumer specific data comprising customer profile data of said consumer.

The examiner asserts that Smolen discloses basing promotions offered to a person or household upon an information profile. The appellant agrees. See Smolen column 1 lines 14-16.

**8. 37 CFR 41.37(c)(1)(viii) Claims appendix. An appendix containing a copy of the claims involved in the appeal..**

Appendix I contains the claims involved in the appeal.

9. **37 CFR 41.37(c)(1)(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner**

Appendix II is the evidence appendix.

The undersigned objects to the requirement to "**statement setting forth where in the record that evidence was entered in the record *by the examiner*.**" In this case, as in many cases, the examiner does not identify rejection that are not represented and does not identify evidence expressly as entered into the record. The evidence is entered as a matter of law, when its entry is of right. The wording in 37 CFR 41.37(c)(1)(ix) in this respect and should not have been promulgated. The undersigned shows below where the evidence was entered into the record, regardless of any action by the examiner.

The "37 CFR 1.132 DECLARATION OF MICHAEL C. SCROGGIE", filed August 17, 1999, was entered in the record *as a matter of law* upon filing of the CPA on 8/17/1999.

The "37 CFR 1.131 DECLARATION OF MICHAEL C. SCROGGIE", filed 4/11/2001, was entered in the record *as a matter of law* upon its filing, because it was filed during pendency and before a final action or appeal.

The "37 CFR 1.131 DECLARATION OF NOEL HEAL", filed 4/11/2001, was entered in the record *as a matter of law* upon its filing, because it was filed during pendency and before a final action and before or concurrent with an appeal.

The '37 CFR 1.132 DECLARATION OF MICHAEL C. SCROGGIE", filed 12/23/2002,

was entered in the record *as a matter of law* upon its filing, because it was filed during pendency and before a final action and before or concurrent with an appeal.

Notwithstanding the foregoing, the examiners, most recently, reopened prosecution with the non final office action dated 5/23/2008, which would have, as a matter of law, resulted in entry of any previously non entered evidence.

10. **37 CFR 41.37(c)(1)(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section**

Appendix III is the related proceedings appendix.

- IV. **37 CFR 41.37(c)(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.**

The brief contains no new or non admitted amendment or evidence.

- V. **37 CFR 41.37(d) - Compliance with 37 CFR 41.37(c)**

The brief complies with paragraph (c).

- VI. **37 CFR 41.37(e) - Time Periods Extendable**

The brief is timely filed. Therefore this section is not applicable.

Respectably Submitted,

8/22/2008

/RichardNeifeld#35,299/

Date

Richard Neifeld

Registration No: 35,299

Attorney of Record

ran

**Printed: August 22, 2008 (4:18pm)**

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8-20-2008.wpd**

**APPENDIX I. 37 CFR 41.37(C)(1)(VIII) - CLAIMS APPENDIX**

50. (Previously Presented) A system for distributing product incentives to consumers over a communication network, comprising:

a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer;

at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network; and

a consumer computer coupled to one of said manufacturer network site and retailer network site via said communication network,

wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

51. (Previously Presented) The system of claim 50, wherein said cooperative network site is configured to store at least one of said manufacturer incentives and retailer incentives in a data base coupled thereto.

52. (Previously Presented) The system of claim 50, wherein, in response to a query from said consumer made over said communication network from said manufacturer network site, said cooperative network site transmits a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site;

said consumer transmits incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site; and

said cooperative network site transmits incentives corresponding to said selection data to said consumer via said manufacturer network site.

53. (Previously Presented) The system of claim 52, wherein said cooperative network site transmits said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site.

54. (Previously Presented) The system of claim 50, wherein, in response to a query from said consumer made over said communication network from said retailer network site, said cooperative network site transmits incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site;

said consumer transmits incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

said cooperative network site transmits incentives corresponding to said selection data to said consumer via said retailer network site.

55. (Previously Presented) The system of claim 50, wherein, in response to a query from said consumer made over said communication network from said retailer network site, said cooperative network site transmits a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site;

said consumer transmits incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

said cooperative network site transmits incentives corresponding to said selection data to said consumer via said retailer network site.

56. (Previously Presented) The system of claim 50, wherein, in response to said consumer transmitting an identification code over said communication network from said retailer network site, said cooperative network site transmits incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, said incentive data is

based on consumer specific data of said consumer associated with said identification code;

said consumer transmits incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

said cooperative network site transmits incentives corresponding to said selection data to said consumer via said retailer network site.

57. (Previously Presented) The system of claim 56, wherein said incentive data is based on said consumer specific data comprising a shopping history of said consumer.

58. (Previously Presented) The system of claim 56, wherein said incentive data is based on said consumer specific data comprising demographic data of said consumer.

59. (Previously Presented) The system of claim 56, wherein said incentive data is based on said consumer specific data comprising customer profile data of said consumer.

60. (Previously Presented) A process for distributing product incentives to consumers over a communication network, comprising:

storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer at a cooperative network site;

coupling at least one of a manufacturer network site and a retailer network site to said cooperative network site via said communication network;

coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network; and

transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

61. (Previously Presented) The process of claim 60, further comprising:

storing at said cooperative network site at least one of said manufacturer incentives and retailer incentives in a data base coupled thereto.

62. (Previously Presented) The process of claim 60, further comprising:

transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site.

63. (Previously Presented) The process of claim 62, further comprising:

transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site.

64. (Previously Presented) The process of claim 60, further comprising:

transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

65. (Previously Presented) The process of claim 60, further comprising:

transmitting from said cooperative network site a consumer personal page including

incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

66. (Previously Presented) The process of claim 60, further comprising:

transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

67. (Previously Presented) The process of claim 66, further comprising:

basing said incentive data on said consumer specific data comprising a shopping history of said consumer.

68. (Previously Presented) The process of claim 66, further comprising:

basing said incentive data on said consumer specific data comprising demographic data of said consumer.

69. (Previously Presented) The process of claim 66, further comprising:

basing said incentive data on said consumer specific data comprising customer profile

data of said consumer.

70. (Previously Presented) A system for distributing product incentives to consumers over a communication network, comprising:

means for storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer at a cooperative network site;

means for coupling at least one of a manufacturer network site and a retailer network site to said cooperative network site via said communication network;

means for coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network; and

means for transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

71. (Previously Presented) The system of claim 70, further comprising:  
means for storing at said cooperative network site at least one of said manufacturer incentives and retailer incentives in a data base coupled thereto.

72. (Previously Presented) The system of claim 70, further comprising:  
means for transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site;

means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site; and

means for transmitting from said cooperative network site incentives corresponding to

said selection data to said consumer via said manufacturer network site.

73. (Previously Presented) The system of claim 72, further comprising:  
means for transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site.

74. (Previously Presented) The system of claim 70, further comprising:  
means for transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

75. (Previously Presented) The system of claim 70, further comprising:  
means for transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

76. (Previously Presented) The system of claim 70, further comprising:

means for transmitting from said cooperative network site incentive data for manufacturer

offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code;

means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

77. (Previously Presented) The system of claim 76, further comprising:  
means for basing said incentive data on said consumer specific data comprising a shopping history of said consumer.

78. (Previously Presented) The system of claim 76, further comprising:  
means for basing said incentive data on said consumer specific data comprising demographic data of said consumer.

79. (Previously Presented) The system of claim 76, further comprising:  
means for basing said incentive data on said consumer specific data comprising customer profile data of said consumer.

80. (Previously Presented) A computer program product comprising a computer storage medium having a computer program embedded in said computer storage medium for causing a computer to distribute product incentives to consumers over a communication network, said computer program performing the steps of:

storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer at a cooperative network site;

coupling at least one of a manufacturer network site and a retailer network site to said

cooperative network site via said communication network;

coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network; and

transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

81. (Previously Presented) The computer program product of claim 80, said computer program further performing the steps of:

storing at said cooperative network site at least one of said manufacturer incentives and retailer incentives in a data base coupled thereto.

82. (Previously Presented) The computer program product of claim 80, said computer program further performing the steps of:

transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site.

83. (Previously Presented) The computer program product of claim 82, said computer program further performing the steps of:

transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via

said manufacturer network site.

84. (Previously Presented) The computer program product of claim 80, said computer program further performing the steps of:

transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

85. (Previously Presented) The computer program product of claim 80, said computer program further performing the steps of:

transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

86. (Previously Presented) The computer program product of claim 80, said computer program further performing the steps of:

transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer

network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

87. (Previously Presented) The computer program product of claim 86, said computer program further performing the steps of:

basing said incentive data on said consumer specific data comprising a shopping history of said consumer.

88. (Previously Presented) The computer program product of claim 86, said computer program further performing the steps of:

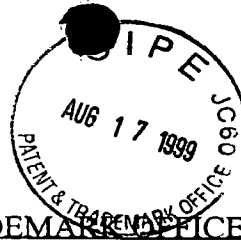
basing said incentive data on said consumer specific data comprising demographic data of said consumer.

89. (Previously Presented) The computer program product of claim 86, said computer program further performing the steps of:

basing said incentive data on said consumer specific data comprising customer profile data of said consumer.

**APPENDIX II. 37 CFR 41.37(C)(1)(IX) EVIDENCE APPENDIX**

7791-0052-25

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :

MICHAEL C. SCROGGIE ET AL : GROUP ART UNIT: 2765

SERIAL NO. 08/873,974 :

FILED: JUNE 12, 1997 : EXAMINER: CAUDLE, P.

FOR: SYSTEM AND METHOD FOR :  
DISTRIBUTING INFORMATION ...

37 C.F.R. §1.132 DECLARATION OF MICHAEL C. SCROGGIE

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

(1) I am named as an inventor in the application identified above.

(2) The articles (i) "Cruising for food ..." ("Cruising") dated April 20, 1996, (ii) "Click for coupons ..." by Peterson dated June 1, 1996, cited in the Office Action mailed September 2, 1998, and (iii) "Catalina Marketing Corporation News Letter ..." dated February 11 and April 19, 1996 referenced in the Office Action mailed June 30, 1999 refer to an initial launch of the Supermarkets Online ("SMO") web site. The initial launch of the SMO web site did not include the subject matter defined by the claims in the application identified above, as indicated by the following paragraphs.

(3) Independent Claim 1 recites a method including the step of "providing information from the database, to a consumer in response to a consumer request made from a consumer communication node connected to the communication network, but without regard for whether the consumer communication node is logged in to the cooperative

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TC 2700 MAIL ROOM

communication site or to a retailer or manufacturer network site, or another independently administered site.” The initial launch of the SMO web site could not perform a method including the step of “providing information from the database, to a consumer in response to a consumer request made from a consumer communication node connected to the communication network, but without regard for whether the consumer communication node is logged in to the cooperative communication site or to a retailer or manufacturer network site, or another independently administered site.”

(4) Independent Claim 14 recites an apparatus including “means installed at cooperating manufacturer and retailer sites, for providing communication linkage between the cooperative communication node and a consumer node logged in to one of the manufacturer or retailer sites, whereby the consumer node receives the product offer information as if logged in directly to the cooperative communication node.” The initial launch of the SMO web site did not use an apparatus including “means installed at cooperating manufacturer and retailer sites, for providing communication linkage between the cooperative communication node and a consumer node logged in to one of the manufacturer or retailer sites, whereby the consumer node receives the product offer information as if logged in directly to the cooperative communication node.”

(5) Independent Claim 20 recites a method including the step of “in response to selection of the banner by a consumer logged in to the independent commercial network site, providing a purchase incentive directly to the consumer [from the purchase incentive server site] for viewing and recording, whereby the consumer can obtain a selected product incentive directly while logged in to the commercial site.” The initial launch of the SMO web site could not perform a method including the step of “in response to selection of the banner by a consumer logged in to the independent commercial network site, providing a purchase

incentive directly to the consumer [from the purchase incentive server site] for viewing and recording, whereby the consumer can obtain a selected product incentive directly while logged in to the commercial site."

(6) Independent Claim 22 recites a method including the step of, "in response to selection of the banner by a consumer logged in to the independent commercial network site, providing a product purchase incentive to the consumer [from the purchase incentive server site] for viewing and recording, whereby the consumer can obtain product purchase incentives directly while logged in to the commercial site." The initial launch of the SMO web site could not perform a method including the step of, "in response to selection of the banner by a consumer logged in to the independent commercial network site, providing a product purchase incentive to the consumer [from the purchase incentive server site] for viewing and recording, whereby the consumer can obtain product purchase incentives directly while logged in to the commercial site."

(7) I am not aware of any public sale and/or use of the subject matter quoted in the paragraphs above that is defined by the claims in this application that occurred more than one year prior to the June 12, 1997 filing date of the application identified above.

(8) I swear under penalty of perjury that the foregoing is true and correct, and I am aware that any untrue statements are punishable by fine or imprisonment, or both, pursuant to 18 USC 1001.

Date

August 5, 1999

Michael C. Scroggie



I:\my\CRV\7791\77910052.132 declaration; RAN\CRV\crv

Dept.: E/M

By: RAN:CRV:abs

OSMM&N File No. 7791-0052-25

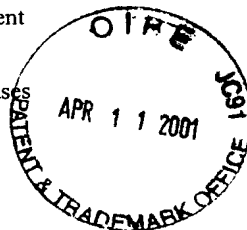
Serial No. 08/873,974

In the matter of the Application of: MICHAEL C. SCROGGIE ET AL

For: SYSTEM AND METHOD FOR DISTRIBUTING INFORMATION  
THROUGH COOPERATIVE COMMUNICATION NETWORK SITES

The following has been received in the U.S. Patent Office on the date stamped hereon:

- ☐ pp. Specification & Claims/Drawings Sheets
- ☐ Combined Declaration, Petition & Power of Attorney pages
- ☐ List of Inventor Names and Addresses
- ☐ Utility Patent Application ☐ CPA
- ☐ Notice of Priority ☐ Priority Doc
- ☐ Check for ☐ Dep. Acct. Order Form
- ☐ Fee Transmittal Form
- ☐ Assignment/PTO 1595 pages:
- ☐ Letter to Official Draftsman
- ☐ Letter Requesting Approval of Drawing Changes
- ☐ Drawings sheets ☐ Formal
- ☒ Cover Letter
- ☒ Amendment with Marked-Up Copy
- ☐ Information Disclosure Statement ☐ PTO-1449
- ☐ Statement of Relevancy
- ☐ IDS/Related/List of Related Cases
- ☐ Restriction Response
- ☐ Rule 132 Declaration
- ☐ Petition for Extension of Time
- ☐ Notice of Appeal
- ☒ Supplemental Appeal Brief under 37 CFR §1.192 with Appendices I and II (In Triplicate)
- ☐ Issue Fee Transmittal
- ☐ White Advance Serial Number Card
- ☒ Remarks in Support of 37 CFR §1.131 Declaration
- ☒ 37 CFR §1.131 Declaration of Michael C. Scroggie with Exhibits A and B
- ☒ 37 CFR §1.131 Declaration of Noel Heal with Exhibits A and B



☐ Election Response

Due Date: N/A

I:\atty\CRV\7791\77910052.fr.wpd

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

Michael C. SCROGGIE et al

: EXAMINER: ROBINSON-BOYCE, A.

SERIAL NO: 09/505,632 :

FILED: February 16, 2000

: GROUP ART UNIT: 2163

FOR: SYSTEM AND METHOD FOR  
DISTRIBUTING INFORMATION...

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

37 CFR §1.131 DECLARATION OF MICHAEL C. SCROGGIE


(1) I, David A. Rochon, David W. Banker and Will Gardenswartz, are the inventors named in the above-noted U.S. Patent Application Serial No. 09/505,632 entitled "SYSTEM AND METHOD FOR DISTRIBUTING INFORMATION THROUGH COOPERATIVE NETWORK SITES," which is a continuation application of U.S. Patent Application Serial No. 08/873,974, filed on June 12, 1997, now allowed.

(2) We conceived of the invention disclosed in the present application prior to May 13, 1997 and the present invention was constructively reduced to practice on the June 12, 1997, filing date of the U.S. Patent Application Serial No. 08/873,974.

(3) Exhibit A is a copy of a letter and an attachment to the letter including an initial invention disclosure and drawings for the 08/873,974 application that I sent to patent attorney Mr. Noel Heal prior to May 13, 1997.

(4) Exhibit B is a copy of billing records from Mr. Noel Heal reflecting work performed in preparation and filing of the 08/873,974 application.

(5) I and Mr. Banker discussed the invention of the 08/873,974 application with Mr. Heal

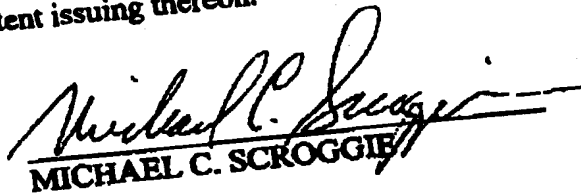


prior to May 13, 1997, I discussed a draft of the 08/873,974 application with Mr. Heal on June 9, 1997 and I and Mr. Gardenswartz discussed a revised draft of the 08/873,974 application with Mr. Heal on June 10, 1997.

(6) A final draft of the 08/873,974 application was filed on June 12, 1997.

(7) I swear under penalty of perjury that the foregoing statements are true and correct, and I am aware that any willful false statements are punishable by fine or imprisonment, or both, pursuant to 18 USC 1001 and that such willful false statements may jeopardize the validity of the present application or any patent issuing thereon.

1/26/01  
DATE

  
MICHAEL C. SCROGGIE

Printed: January 25, 2001  
I:\atty\CRV\7791\77910103.scroggie declaration.wpd

Super Market  
Online

MEMORANDUM

TO: Noel Heal  
cc: David Rochon, Will Gardenswartz, Dave Banker  
FROM: Mike Scroggie MS  
SUBJECT: Web Site Internetworking Patent Application  
DATE: [REDACTED]

Attached is an overview of a new invention for which we need to submit a patent application. Although initially we plan to address the supermarket/package goods arena, the concept is much broader and claims should be developed to cover:

- The Supermarket/Consumer packaged goods industry
- Retail industries for hard and soft goods *clothing*
- Any industry where information can be aggregated and disbursed via a computer network based on a consumer's (or third party's) selection

We are on a timeline to begin pitching this concept to retailers about [REDACTED] therefore we would like the patent application to be filed by that time. In the meantime, we will share the concept with third parties only under a NDA. Please advise me as to the disclosure rules we must follow to ensure the eventual patent's validity.

Please get back to me as to what additional information you need to draft the application and what filing date is realistic.

CONFIDENTIAL

EXHIBIT A  
SERIAL NO. 09/505,632

SuperMarkets Online™  
Web Site Internetworking

Web Site Internetworking Description

This document describes an invention of SuperMarkets Online™ (SMO) whereby Web Sites on the Internet are linked together to create a comprehensive and complimentary interchange to allow consumers to locate offers and information in their areas of interest in their local area. In its initial implementation, SMO will link the Web sites of consumer packaged goods manufacturers and supermarket retailers and deliver, via a central server, product offers and supermarket specials to consumers regardless whether the consumer visits the manufacturer site, the retailer site or SMO's cooperative site. This concept of a "Offer Locator" is illustrated on the attached charts and described further below. *SMO's?*

*Rel.* This invention provides a solution to two outstanding issues in the packaged goods industry: how manufacturers communicate to consumers where their products are on special or "deal" in the consumer's local area and how to quickly report back to the manufacturer the results of the retail promotion of their products; and how retailers cost effectively communicate to consumers what manufacturer offers are available in their stores. The retailer specials take the form of special features (i.e., endcap displays and the like), price markdowns and meal solutions for specific manufacturer products. The manufacturer offers include coupons, rebates, samples, product information, sweepstakes, contests, recipes, questionnaires and surveys, audio messages and advertising. Thus, this *film* targeting capability applies not only to the national offers, but also to the weekly offers supplied by the retailers, therefore SMO must possess data about which brands/products are on special at a given retailer (down to the store level).

This information regarding which stores have which brands/products on special means that once SMO has developed a database of manufacturer offers available at what retail locations that, given a brand or product, the consumer could search for retail locations where the specified brand or product is on special. Conversely, SMO stores in its database manufacturer offers available and allows the consumer to query (or target specific offers via the personal page) what manufacturer offers are available from the retailer site. This is the essence of the Offer Locator concept and internetworking Web sites -- it provides a mechanism to efficiently inform and educate the consumer on a timely basis as to what offers (retail specials and manufacturer offers) are available regardless what site the user accesses. *Any inroads for internet web sites? in other countries? 777 FILM!*

There are many applications of the Offer Locator concept. For example, a "banner ad" placed by a national manufacturer could, upon being selected ("clicked" in Internet parlance), trigger an intermediate step where the consumer would then be asked to enter his or her zip code. A search would then be initiated by the SMO Server of the offer database the would match the content of the manufacturers ad (which could be a brand level ad or a product level ad) with retailer locations featuring the brand/product that are closest to the consumer's zip code. *little:*

One of the main applications of the Offer Locator is within the domain of a manufacturer's web site. In this instance, various hot links about the manufacturer's brands/products will *which?*

**SuperMarkets Online<sup>SM</sup>**  
**Web Site Internetworking**

2

use the Offer Locator to relate clicks on the "within site" banners to retailer locations featuring the brands/products within proximity of the consumer.

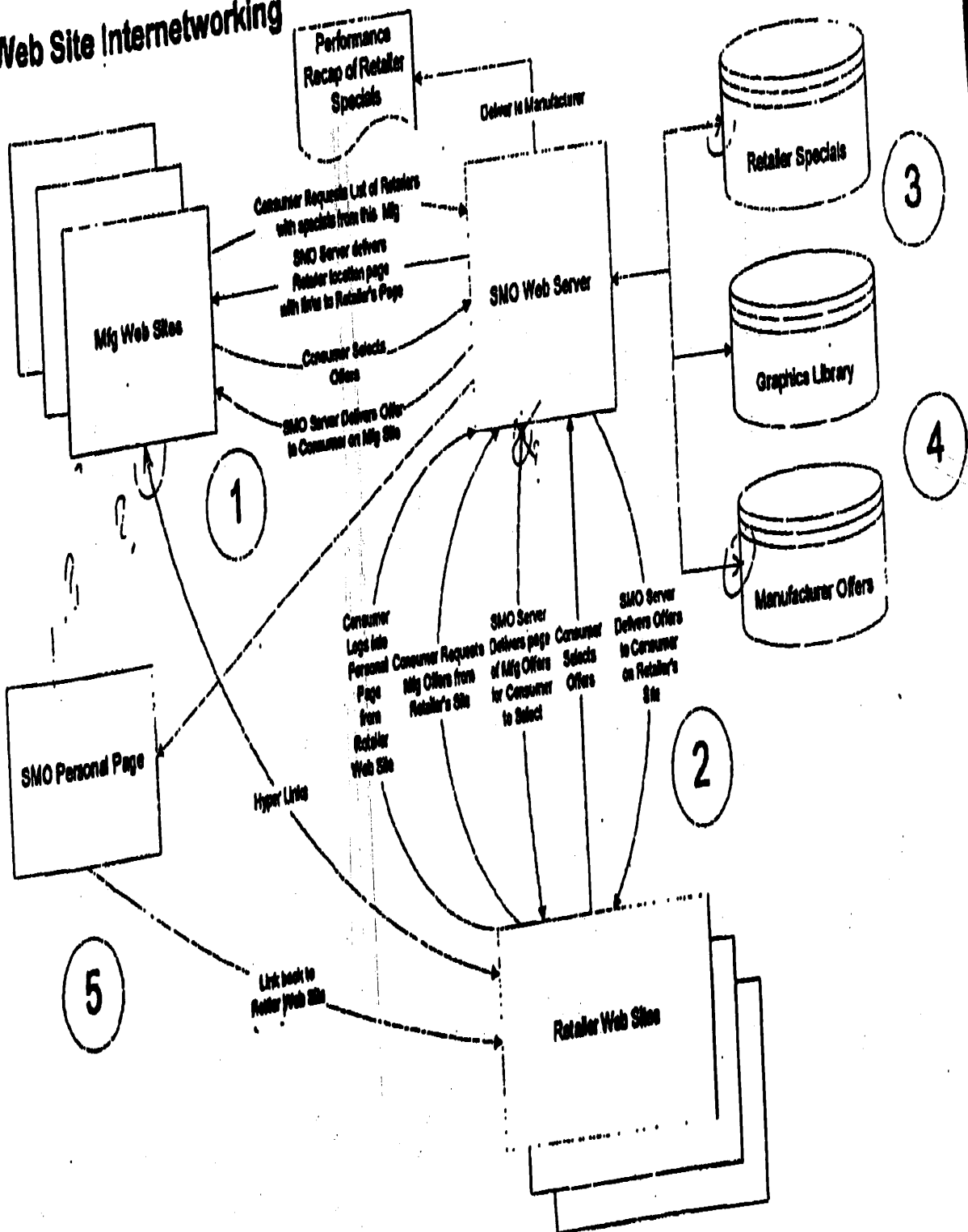
These are just representative examples of the application of the present invention. Searches do not have to be by zip code (e.g., they could be by street address, or by a credit card number, or online membership account, or by a "cookie"), and the intermediate give-us-your-search criteria step could ask a variety of other questions like "Who is your favorite retailer?" or "Of the following brands offered by manufacturer X which do you care about most?" Likewise, the point-of-entry into the Offer Locator service does not have to be a "banner ad." It could, for example, be triggered by clicking on a manufacturer's listing in an electronic Yellow Pages. In all cases the essence of the Offer Locator is the same. It relates an ad or promotion to a location where the advertised or promoted product is, first and foremost available, and then quite likely on special/featured. By linking the manufacturer and retailer sites together, all parties benefit; the manufacturer is able to inform the consumer where their products are featured, the retailer is able to efficiently promote their stores by highlighting what manufacturer offers are available and the consumer benefits by being better informed as to where to shop to save money.

The initial implementation of the present invention is illustrated in the following charts. The "Web Site Internetworking" chart graphically shows the relationship between the various components and the links established by the SMO Network. The SMO Server is paramount to this design. It provides a central reservoir of manufacturer and retailer offers and the relationships and properties of the network links. Whenever the consumer desires to locate an offer, he/she visits the applicable site in the network (either manufacturer, retailer or SMO's cooperative site) and initiates the Offer Locator application. The parameters of the search are entered by the consumer and the corresponding results are delivered by the SMO Server to the applicable site (via hyperlinks) and displayed to the consumer by his/her browser software. In the case of the consumer querying the retailer's site or SMO's cooperative site, the results may be delivered in the form of SMO's Personal Page. In order to timely inform the manufacturer of the results of the retail promotion, SMO extracts item movement data from the store's point-of-sale system and summarizes the results of the promotion back to the manufacturer in the form of Internet delivered performance reports.

*Consumer site*  
*within? (man. in)*

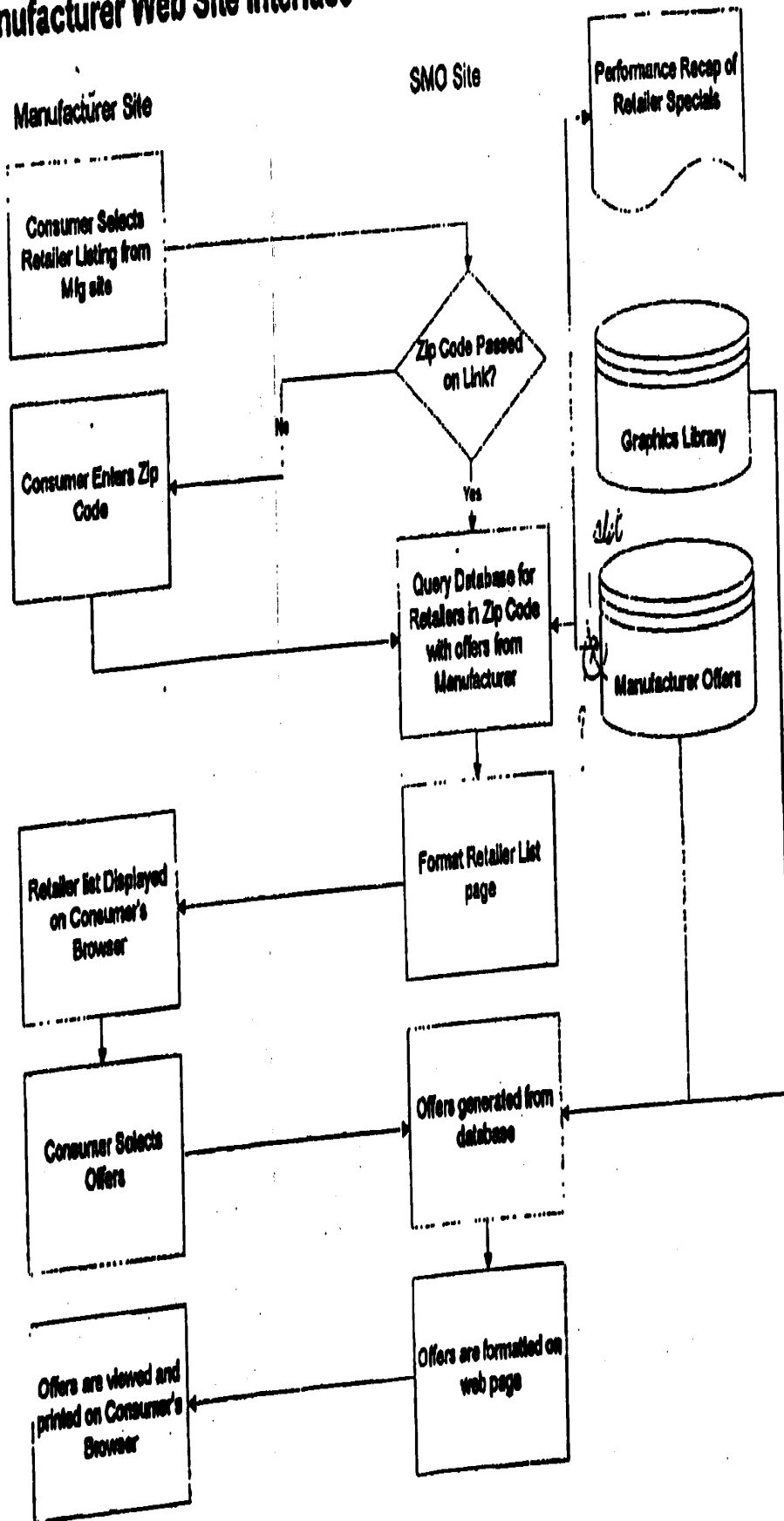
Subordinate Charts 1 through 5 illustrate the detailed process flow within the various components of the network. Chart 1 shows the processing steps which are initiated (on both the manufacturer's site and SMO's site) when the consumer visits the manufacturer site and selects the Offer Locator application. Chart 2 shows the corresponding process flow from the retail site interface perspective. Chart 3 shows the process of capturing or entering retail special information into the SMO database, while Chart 4 illustrates the manufacturer offer capture process. Chart 5 shows the processing steps initiated by the SMO Server to navigate the consumer through the Personal Page which delivers targeted offers and specials to the consumer's preferences and buying habits.

# Web Site Internetworking



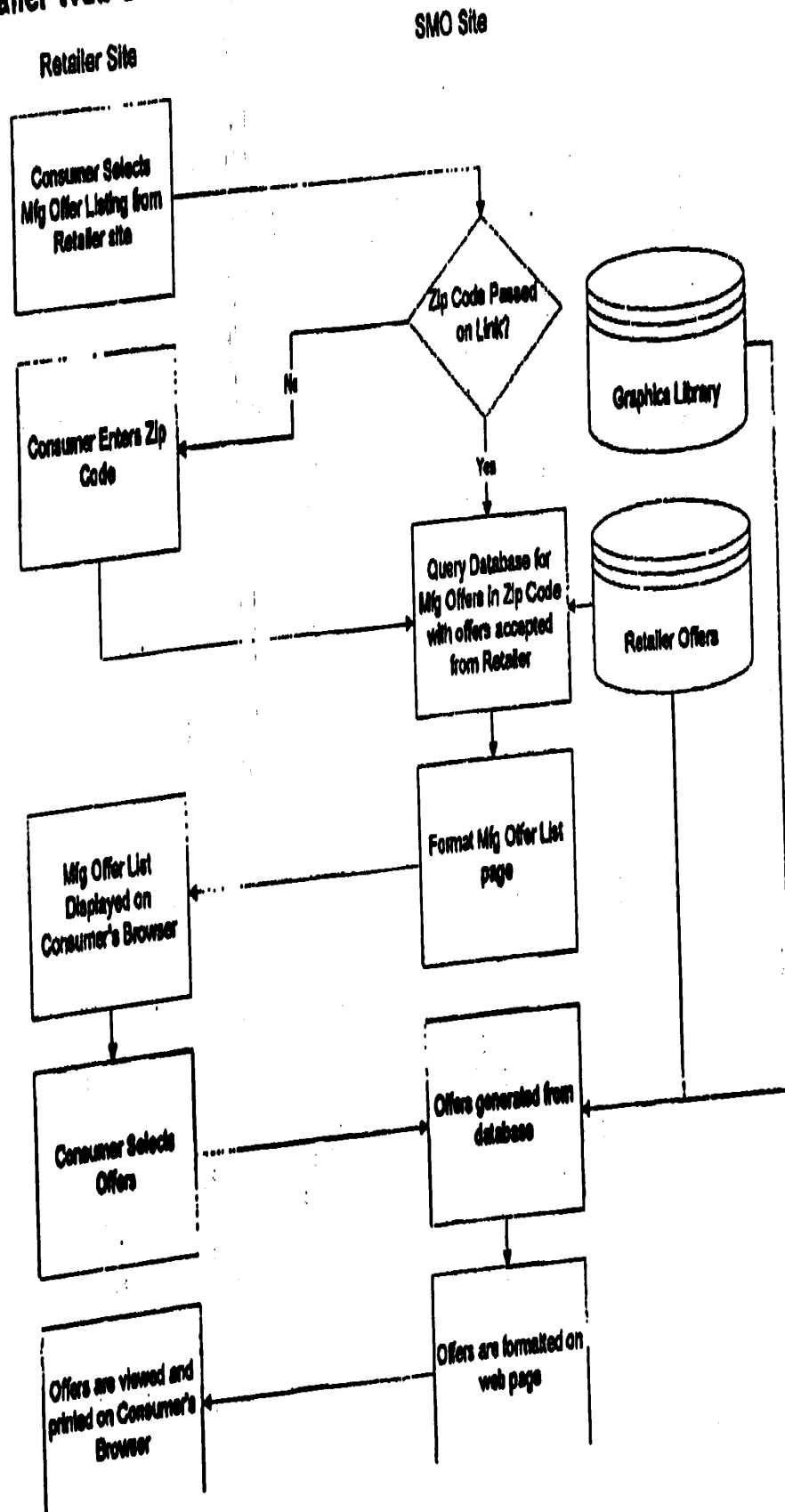
1

# Manufacturer Web Site Interface



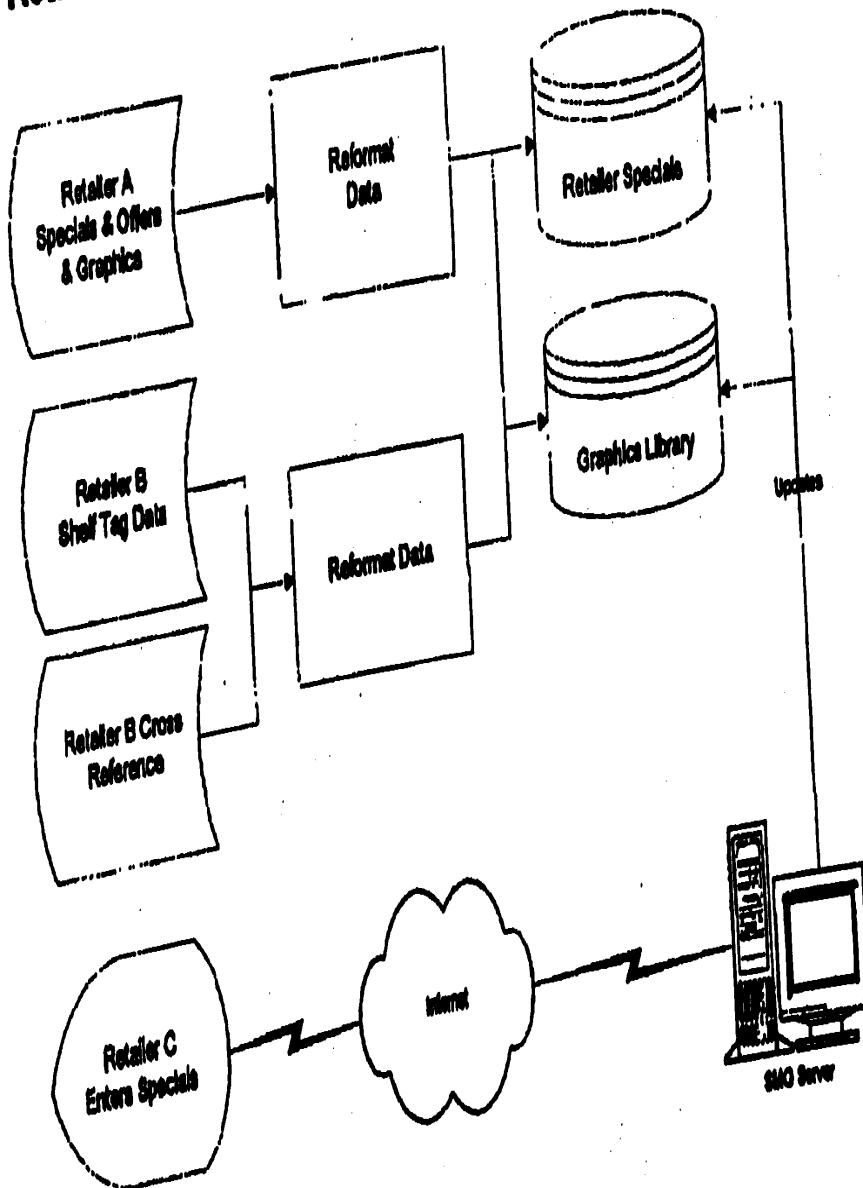
2

## Retailer Web Site Interface



3

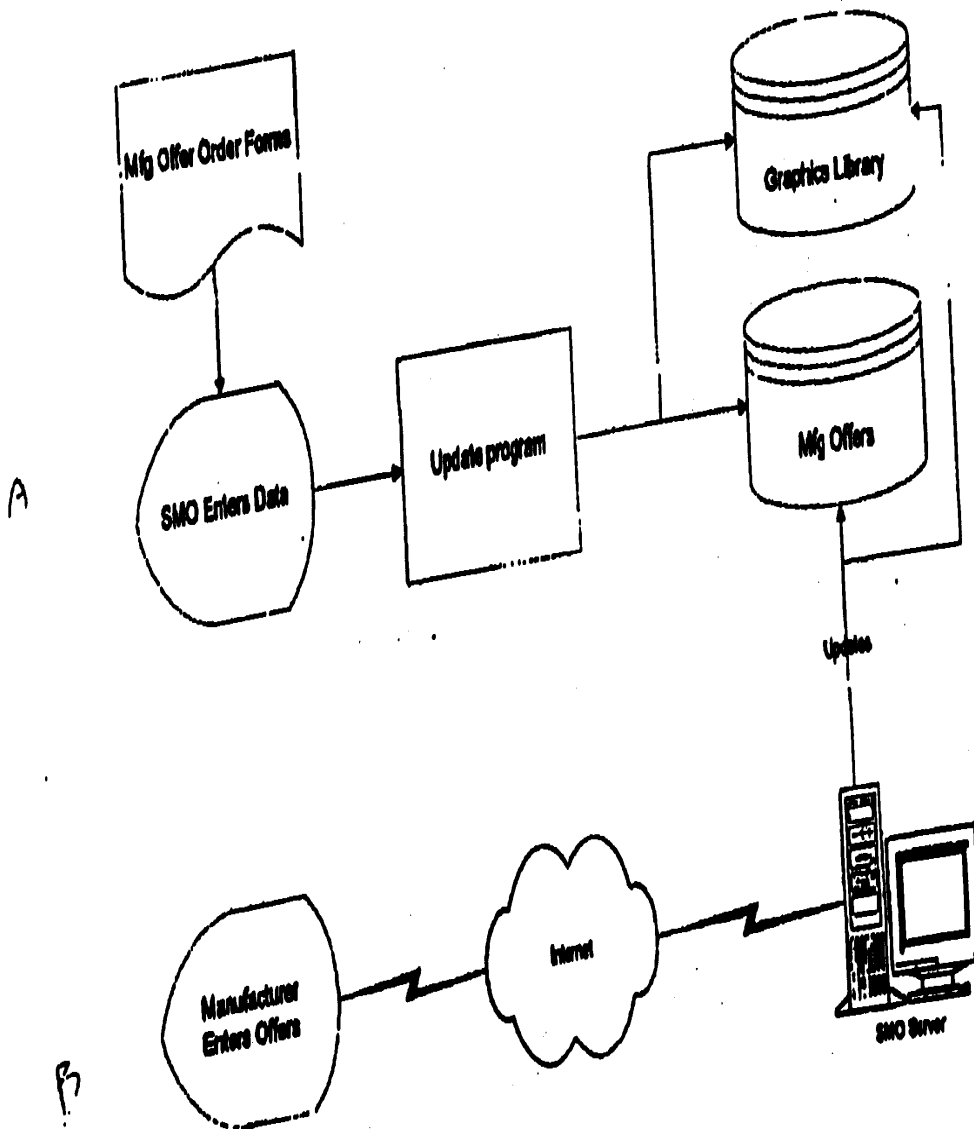
# Retailer Specials Maintenance



A B C: what's the difference?

4

# Manufacturer Offers Maintenance

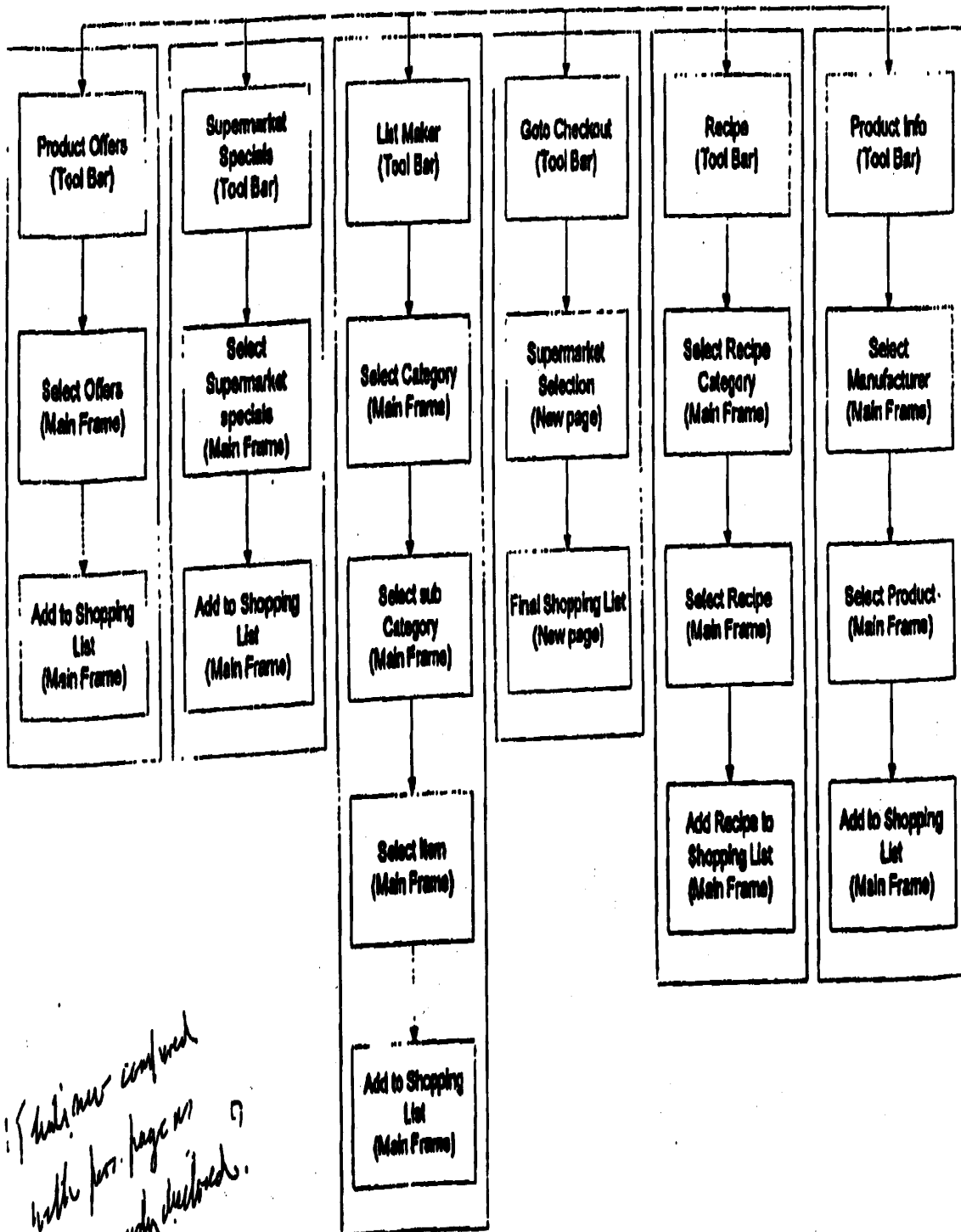


A/B: What's the difference?

5

# Personal Page

First Page  
(Intro Page)



*Handwritten note:*  
 This new content  
 will be page as  
 incorrectly defined.

CHILDLINE  
 :All  
 :All  
 :3  
 :Open  
 :All  
 :All at level All  
 :Not checked  
 :All  
 :All  
 :Not checked

	Description	Matter	BL Slip Value
	Review disclosure material prior to meeting with inventors	-3	300.00
	Meeting with Mike Scroggie and Dave Banker to discuss details of new invention disclosure	-3	400.00
1/97	Preparation of draft patent application	-3	240.00
1/97	Preparation of draft patent application	-3	600.00
1/97	Preparation of draft application	-3	1880.00
1/97	Preparation of patent application and modification of drawings	-3	1760.00
1/97	Review and revise the draft application	-3	500.00
1/97	Revision of application draft and adding new material on "value banner"	-3	1240.00
1/97	Discussion with Mike Scroggie; revision of application and claims	-3	660.00
1/97	Complete revision of draft application; phone calls to Mike Scroggie and Will Gerdanewitz	-3	300.00
2/97	Preparation of transmittal papers	-3	400.00
3/97	Airborne Exp. - formal papers to Mike Scroggie	-3	9.75
5/98	Application filing fee and assignment fee, paid with filing of formal papers (already paid by Catalina Supermarkets OnLine -- see below)	-3	1190.00
4/98	Download copy of Sun Microsystems European app. no. EP 0 809202A2	-3	4.95
3/98	Correspondence with foreign associates to send copies of application for filing	-3	300.00
END TOTAL			9784.70

EXHIBIT B

SERIAL NO. 09/505,632

7791-0103-25X CONT  
CAT/34-SCRO-CONT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

Michael C. SCROGGIE et al

: EXAMINER: ROBINSON-BOYCE, A.

SERIAL NO: 09/505,632

FILED: February 16, 2000

: GROUP ART UNIT: 2163

FOR: SYSTEM AND METHOD FOR  
DISTRIBUTING INFORMATION...

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

37 CFR §1.131 DECLARATION OF NOEL HEAL

(1) I am the patent attorney who prepared and filed U.S. Patent Application Serial No. 08/873,974, on June 12, 1997, on behalf of the inventors Michael C. Scroggie, David A. Rochon, David W. Banker and Will Gardenswartz.

(2) The subject invention disclosed in the 08/873,974 application was conceived prior to May 13, 1997 and the present invention was constructively reduced to practice on the June 12, 1997, filing date of the U.S. Patent Application Serial No. 08/873,974.

(3) Exhibit A is a copy of a letter and an attachment to the letter including an initial invention disclosure and drawings for the 08/873,974 application that I received from Mr. Scroggie prior to May 13, 1997.

(4) Exhibit B is a copy of my billing records reflecting work performed in preparation and filing of the 08/873,974 application.

(5) I discussed the invention of the 08/873,974 application with Mr. Scroggie and Mr. Banker prior to May 13, 1997, I worked on preparing a draft of the 08/873,974 application on May 12, 15, 16, 19, 21 and June 4, 1997, I discussed the draft of the 08/873,974 application

with Mr. Scroggie on June 9, 1997 and I discussed the revised draft of the 08/873,974 application with Mr. Scroggie and Mr. Gardenswartz on June 10, 1997.

(6) I filed the final draft of the 08/873,974 application on June 12, 1997.

(7) I swear under penalty of perjury that the foregoing statements are true and correct, and I am aware that any willful false statements are punishable by fine or imprisonment, or both, pursuant to 18 USC 1001 and that such willful false statements may jeopardize the validity of the present application or any patent issuing thereon.

1/26/01  
DATE

  
\_\_\_\_\_  
NOEL HEAL

Printed: January 25, 2001  
[\\atty\\CRV\\7791\\77910103.heal declaration.wpd

Super Market  
Online

MEMORANDUM

TO: Noel Heal  
cc: David Rochon, Will Gardenswartz, Dave Banker  
FROM: Mike Scroggie *MS*  
SUBJECT: Web Site Internetworking Patent Application  
DATE: [REDACTED]

Attached is an overview of a new invention for which we need to submit a patent application. Although initially we plan to address the supermarket/package goods arena, the concept is much broader and claims should be developed to cover:

- The Supermarket/Consumer packaged goods industry
- Retail industries for hard and soft goods *clothing*
- Any industry where information can be aggregated and disbursed via a computer network based on a consumer's (or third party's) selection

We are on a timeline to begin pitching this concept to retailers about [REDACTED], therefore we would like the patent application to be filed by that time. In the meantime, we will share the concept with third parties only under a NDA. Please advise me as to the disclosure rules we must follow to ensure the eventual patent's validity.

Please get back to me as to what additional information you need to draft the application and what filing date is realistic.

CONFIDENTIAL

EXHIBIT A

SERIAL NO. 09/505,632

SuperMarkets Online™  
Web Site Internetworking

Web Site Internetworking Description

This document describes an invention of SuperMarkets Online™ (SMO) whereby Web Sites on the Internet are linked together to create a comprehensive and complimentary interchange to allow consumers to locate offers and information in their areas of interest in their local area. In its initial implementation, SMO will link the Web sites of consumer packaged goods manufacturers and supermarket retailers and deliver, via a central server, product offers and supermarket specials to consumers regardless whether the consumer visits the manufacturer site, the retailer site or SMO's cooperative site. This concept of a "Offer Locator" is illustrated on the attached charts and described further below. SMO's?

This invention provides a solution to two outstanding issues in the packaged goods industry: how manufacturers communicate to consumers where their products are on special or "deal" in the consumer's local area and how to quickly report back to the manufacturer the results of the retail promotion of their products; and how retailers cost effectively communicate to consumers what manufacturer offers are available in their stores. The retailer specials take the form of special features (i.e., end-caps displays and the like), price markdowns and meal solutions for specific manufacturer products. The manufacturer offers include coupons, rebates, samples, product information, sweepstakes, contests, recipes, questionnaires and surveys, audio messages and advertising. Thus, this targeting capability applies not only to the national offers, but also to the weekly offers supplied by the retailers, therefore SMO must possess data about which brands/products are on special at a given retailer (down to the store level).

This information regarding which stores have which brands/products on special means that once SMO has developed a database of manufacturer offers available at what retail locations that, given a brand or product, the consumer could search for retail locations where the specified brand or product is on special. Conversely, SMO stores in its database manufacturer offers available and allows the consumer to query (or target specific offers via the personal page) what manufacturer offers are available from the retailer site. This is the essence of the Offer Locator concept and internetworking Web sites - it provides a mechanism to efficiently inform and educate the consumer on a timely basis as to what offers (retail specials and manufacturer offers) are available regardless what site the user accesses.

There are many applications of the Offer Locator concept. For example, a "banner ad" placed by a national manufacturer could, upon being selected ("clicked" in Internet parlance), trigger an intermediate step where the consumer would then be asked to enter his or her zip code. A search would then be initiated by the SMO Server of the offer database the would match the content of the manufacturer's ad (which could be a brand level ad or a product level ad) with retailer locations featuring the brand/product that are closest to the consumer's zip code.

One of the main applications of the Offer Locator is within the domain of a manufacturer's web site. In this instance, various hot links about the manufacturer's brands/products will

any from  
for internet  
web site  
in other  
cf. (history mi  
777777

little

where

**SuperMarkets Online<sup>SM</sup>**  
**Web Site Internetworking**

2

use the Offer Locator to relate clicks on the "within site" banners to retailer locations featuring the brands/products within proximity of the consumer.

These are just representative examples of the application of the present invention. Searches do not have to be by zip code (e.g., they could be by street address, or by a credit card number, or online membership account, or by a "cookie"), and the intermediate give-us-your-search criteria step could ask a variety of other questions like "Who is your favorite retailer?" or "Of the following brands offered by manufacturer X which do you care about most?" Likewise, the point-of-entry into the Offer Locator service does not have to be a "banner ad." It could, for example, be triggered by clicking on a manufacturer's listing in an electronic Yellow Pages. In all cases the essence of the Offer Locator is the same. It relates an ad or promotion to a location where the advertised or promoted product is, first and foremost available, and then quite likely on special/featured. By linking the manufacturer and retailer sites together, all parties benefit; the manufacturer is able to inform the consumer where their products are featured, the retailer is able to efficiently promote their stores by highlighting what manufacturer offers are available and the consumer benefits by being better informed as to where to shop to save money.

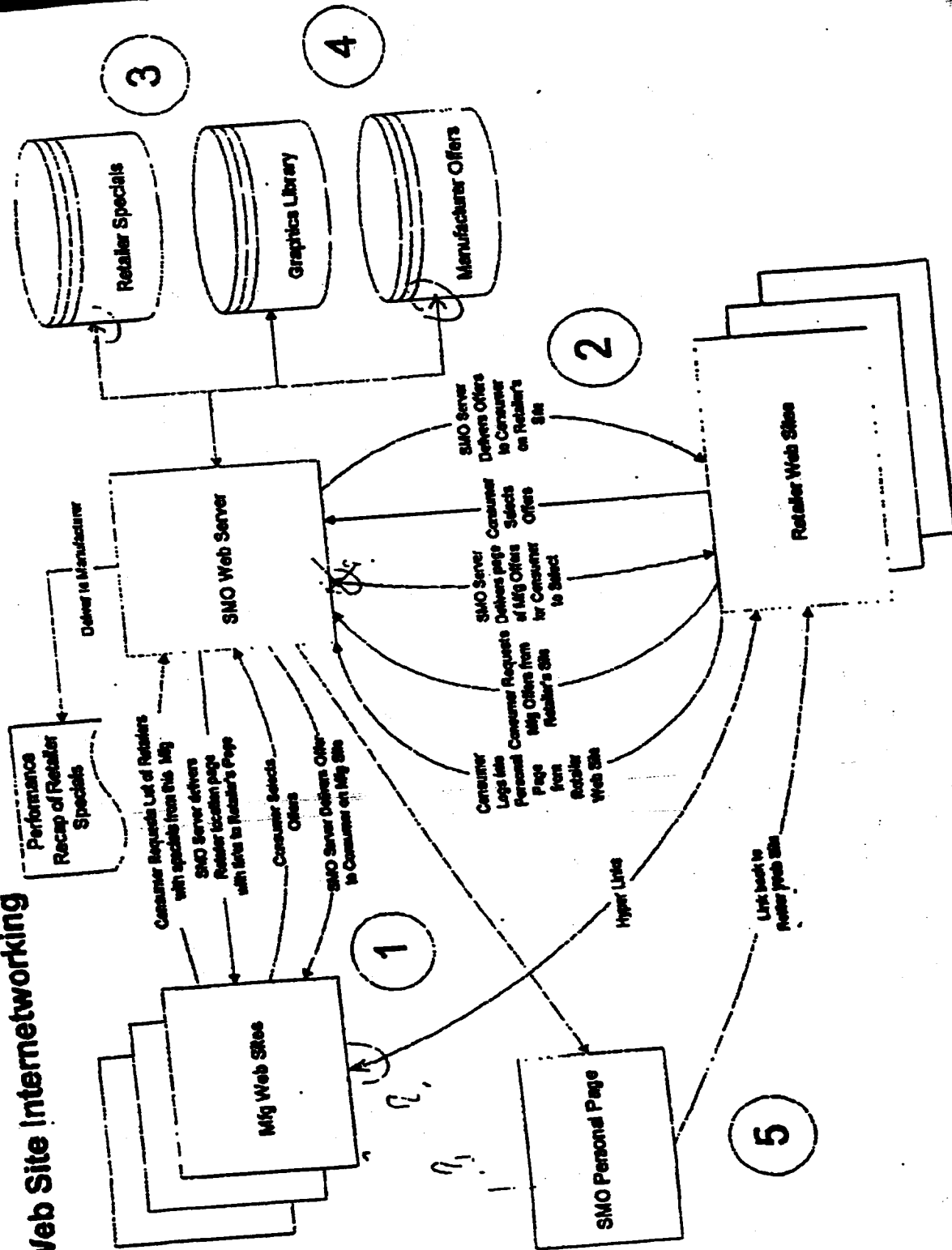
The initial implementation of the present invention is illustrated in the following charts. The "Web Site Internetworking" chart graphically shows the relationship between the various components and the links established by the SMO Network. The SMO Server is paramount to this design. It provides a central reservoir of manufacturer and retailer offers and the relationships and properties of the network links. Whenever the consumer desires to locate an offer, he/she visits the applicable site in the network (either manufacturer, retailer or SMO's cooperative site) and initiates the Offer Locator application. The parameters of the search are entered by the consumer and the corresponding results are delivered by the SMO Server to the applicable site (via hyperlinks) and displayed to the consumer by his/her browser software. In the case of the consumer querying the retailer's site or SMO's cooperative site, the results may be delivered in the form of SMO's Personal Page. In order to timely inform the manufacturer of the results of the retail promotion, SMO extracts item movement data from the store's point-of-sale system and summarizes the results of the promotion back to the manufacturer in the form of Internet delivered performance reports.

*Consumer site*

*when? (man. in)*

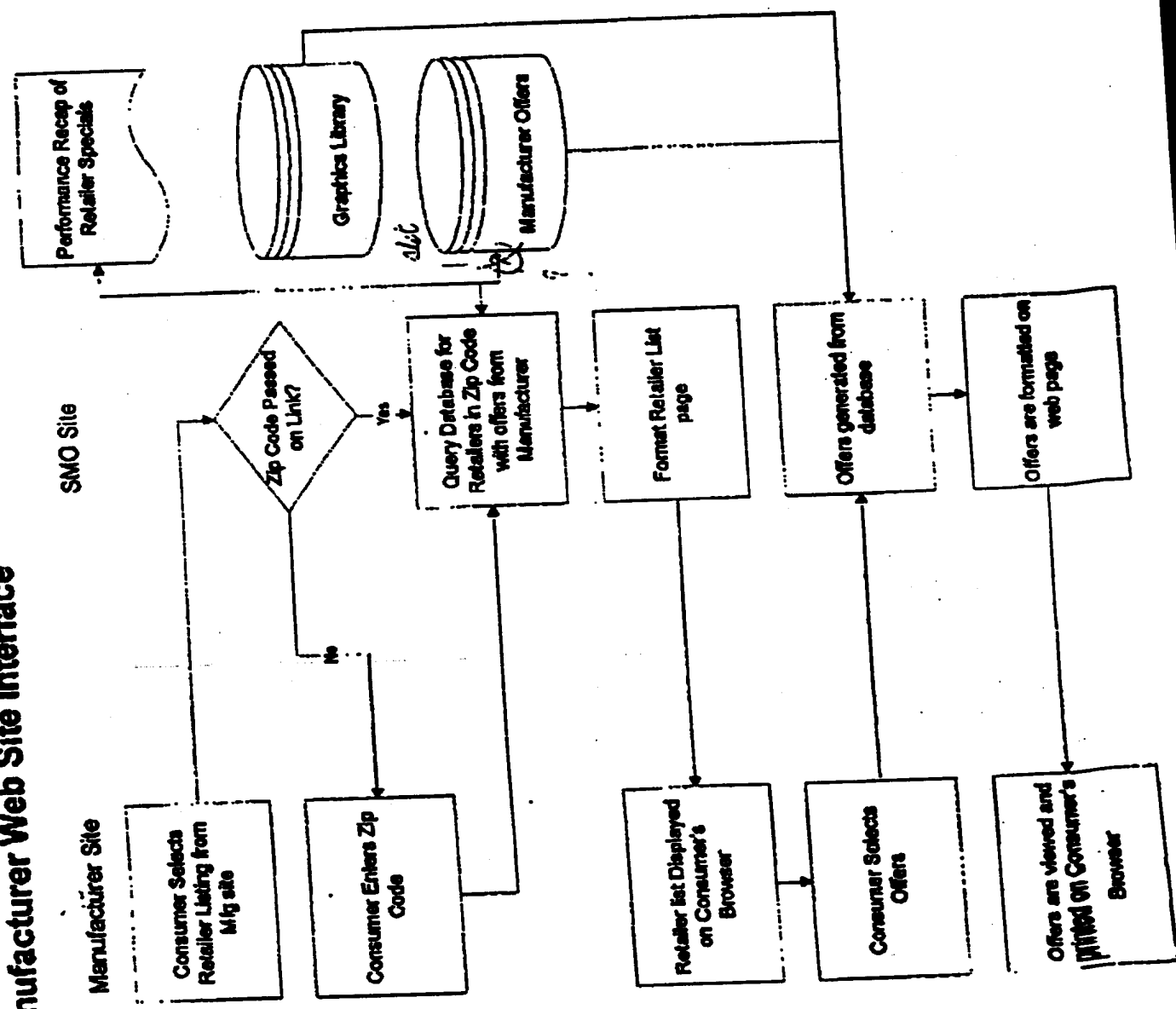
Subordinate Charts 1 through 5 illustrate the detailed process flow within the various components of the network. Chart 1 shows the processing steps which are initiated (on both the manufacturer's site and SMO's site) when the consumer visits the manufacturer site and selects the Offer Locator application. Chart 2 shows the corresponding process flow from the retail site interface perspective. Chart 3 shows the process of capturing or entering retail special information into the SMO database, while Chart 4 illustrates the manufacturer offer capture process. Chart 5 shows the processing steps initiated by the SMO Server to navigate the consumer through the Personal Page which delivers targeted offers and specials to the consumer's preferences and buying habits.

# Web Site Internetworking



1

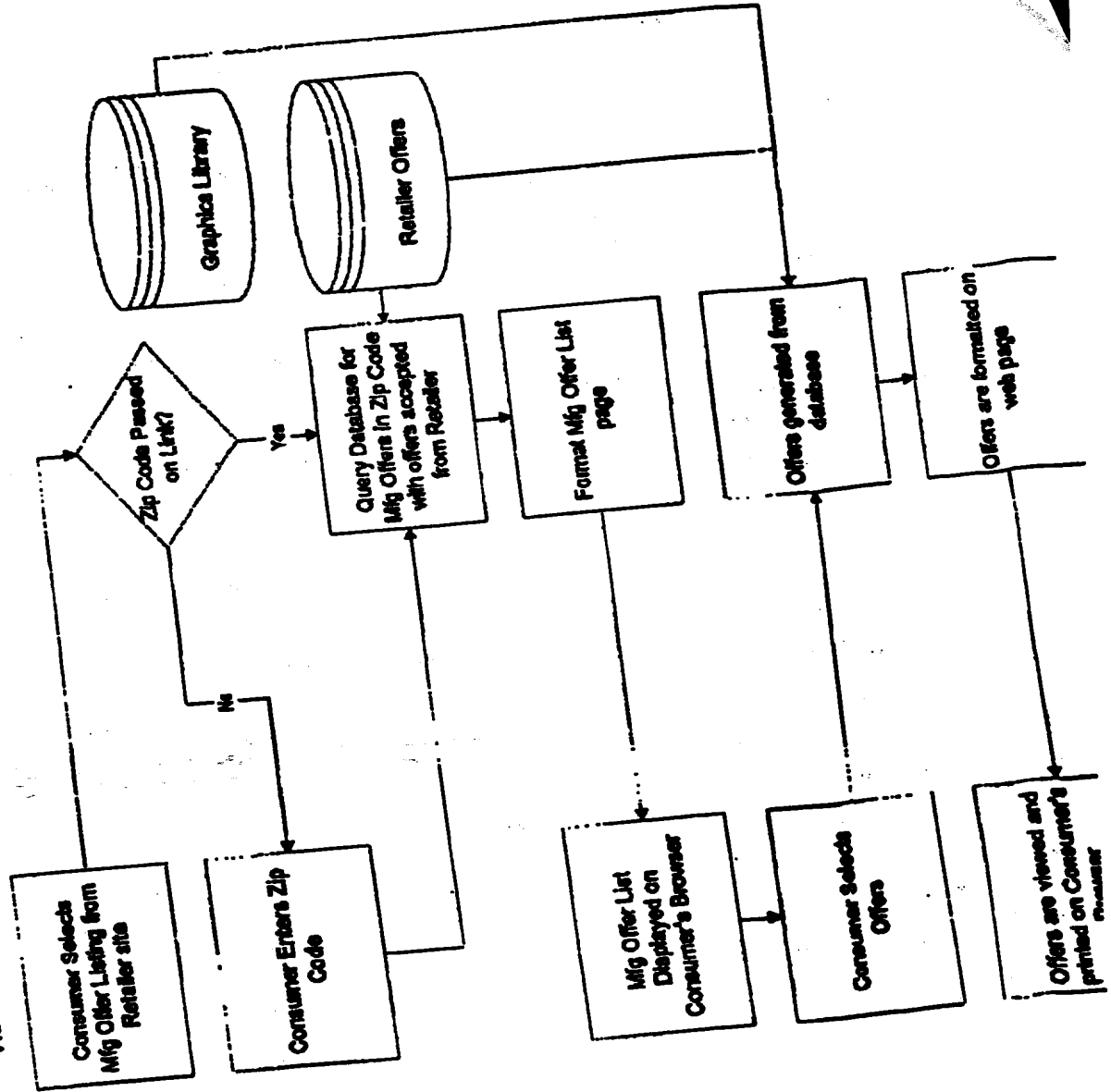
# Manufacturer Web Site Interface



## 2 Retailer Web Site Interface

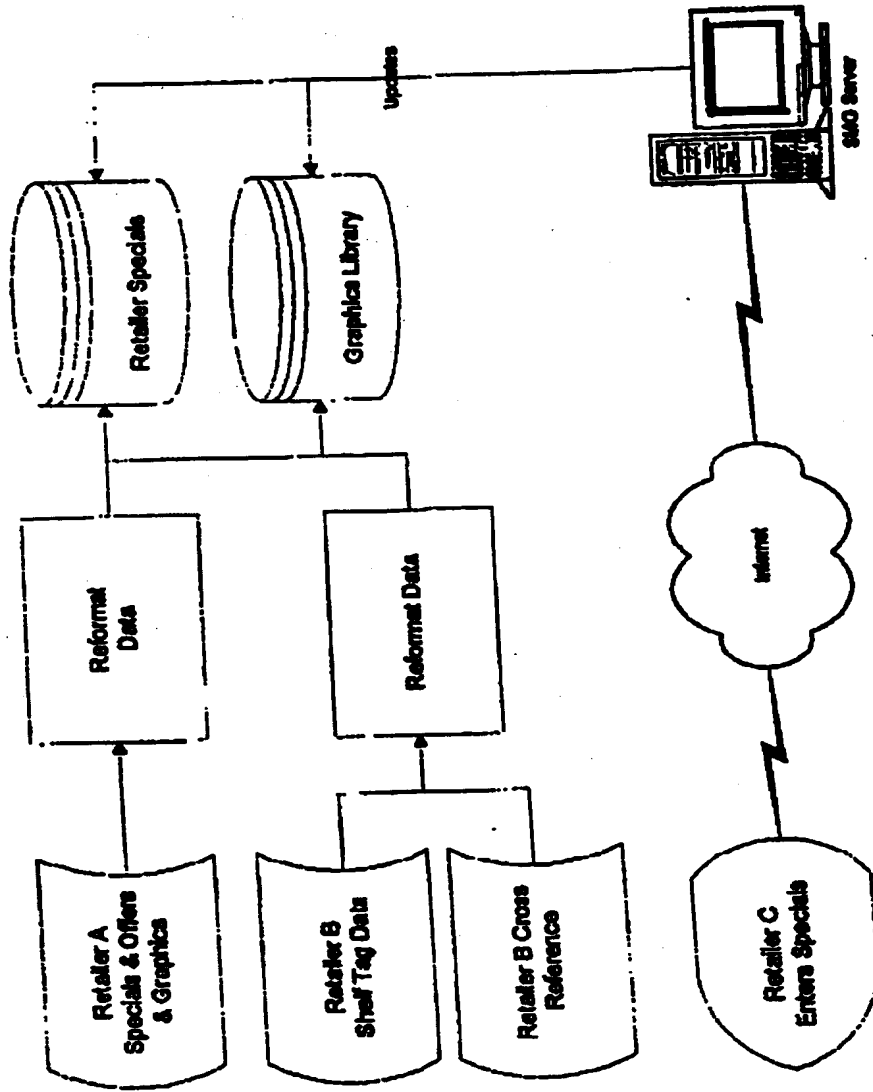
SMO Site

Retailer Site



3

## Retailer Specials Maintenance



A B C: What's the difference?

CAT34-SCRO-US

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :  
SCROGGIE ET AL. : GROUP ART UNIT: 2163  
SERIAL NO. 08/873,974 :  
CPA FILED: AUGUST 17, 1999 : EXAMINER: ROBINSON, BOYCE A.  
FOR: SYSTEM AND METHOD FOR :  
DISTRIBUTING INFORMATION  
THROUGH COOPERATIVE  
COMMUNICATION NETWORK SITES

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

37 CFR 1.132 DECLARATION OF MICHAEL C. SCROGGIE

- (1) I am one of the inventors for the application identified above.
- (2) I refer herein to the Office Action dated September 23, 2002.
- (3) Based upon my knowledge of the fields or programming and related knowledge in the marketing industry, it is my understanding that one of ordinary skill in the arts to which my inventions disclosed and claimed in this application relate would have had at least an undergraduate degree in computer science, knowledge of computer programming of web sites using back end databases, and at least a passing knowledge of marketing and the use of promotions to affect consumer behavior..
- (4) The 12 limitations alleged by the examiner as not supported by the specification are in fact supported by the specification. That is, one of ordinary skill in the art would have understood that I was able to make and use systems and methods including those limitations by reading the originally filed disclosure of this application. A copy of that disclosure is **exhibit (1)** to this declaration. The following claim chart shows by page and line number specifically where each of the 12 limitations is described in the originally filed disclosure. Each of those sections of text contains sufficient explanation of the relevant recitation objected to by the examiner to have informed one skilled in the art that I had conceived of and knew how to implement the systems and methods containing structure or function corresponding to those recitations.

Therefore, it is my opinion that the examiner's rejections of claims containing those limitations as because of the specification allegedly not teaching one of ordinary skill in the art that I was in possession of systems and methods including these limitation are improper.

5. First Assertion

<b>Office Action at page 2 line 22 to page 3 line 2 alleges no original disclosure of:</b>	<b>Original disclosure of the recited limitations:</b>
“transmitting from said cooperative network site	Page 9 lines 26-27; and FIG. 1 #14.
said geographically limited list of retailers	Page 3, lines 21-22; Page 9 lines 24-26; and FIG 3 #50, #52, #54, #56.
based on a postal code provided by said consumer	Page 9 lines 20-24; and FIG. 2 #32, #34, #36. Page 10 lines 7-9; and FIG. 3 #52, #54, #56.
to said cooperative network site	Page 9 lines 24-26; and FIG 1, #14. Page 8 lines 16-18; FIG. 4 #14, FIG 5 #14, and FIG. 7, #124 through #136.
via said manufacturer network site”	Page 9 lines 26-27; FIG. 1 #10; and FIG 2 #10.

6. Second Assertion

<b>Office Action at page 3 lines 2-10 alleges no original disclosure of:</b>	<b>Original disclosure of the recited limitations:</b>
“transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site,	FIG. 1 #12, #14, #16; page 8 lines 18-19; page 9 lines 3-14; and page 10, lines 11-12.
in response to a query from said consumer made over said communication network from said retailer network site;	Page 3, lines 27-28; page 4, lines 1-2;,, age 8 lines 24-25; FIG. 1 #12, #14, FIG. 3 #50, #54, #62; page 9 lines 3-7 and lines 10-11; and page 10 lines 5-7 and lines 12-13.
transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and	Page 3 line 29; page 9 lines 12-13; FIG. 1 #12, #14; and FIG. 3 #64, #66, #68.

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer networks site”	Page 3 lines 1-2; p page 10 line 1-2; page 9 lines 13-14FIG. 1 #12, #14; and FIG. 3 #66, #68.
---	---

7. Third Assertion

Office Action at page 3 lines 11-19 alleges no original disclosure of:	Original disclosure of the recited limitations:
“transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site,	FIG. 1 # 12,#14, #16, #22; FIG. 3; page 8 lines 18-19; page 9 lines 3-11; page 11 lines 8-17; and page 13 lines 6-19.
in response to a query from said consumer made over said communication network from said retailer network site;	FIG. 1 #12, #14; page 8 lines 24-25; page 9 lines 3-7 and page 11 lines 8-10.
transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and	FIG. 1 #12, #14 ; and page 9 lines 12-13.
transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer networks site”	FIG. 1 #12, #14 ; FIG 3 #64, #66, #68; page 4 lines 1-2; page 10 line 3; page 9 lines 13-14.

8. Fourth Assertion

Office Action at page 3 line 19 to page 4 line 6 alleges no original disclosure of:	Original disclosure of the recited limitations:
“transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site,	FIG. 1 #12, #14, #16; FIG. 3; page 8 lines 18-19; page 9 lines 12-13; page 12 lines 6-20; page 13 lines 20-24; and page 14 lines 1-16.

in response to a query from said consumer made over said communication network from said retailer network site;	FIG. 1 #12, #14; FIG 3 #50, #54; page 3 lines 27-29; and page 9 lines 7-13.
transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and	FIG. 1, #12, #14; FIG. 3 #62 ; page 9 lines 11-13; and page 10 lines 11-12.
transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer networks site”	FIG. 1 #12, #14; FIG. 3, #66, #68; page 4 lines 1-2 ; page 9 lines 12-14; and page 10 lines 13-16.

9. Fifth Assertion

<b>Office Action at page 4 line 6-9 alleges no original disclosure of:</b>	<b>Original disclosure of the recited limitations:</b>
“transmitting from said cooperative network site	Page 8 lines 22-24; page 9 lines 26-27; FIG. 1 # 10, #14; and FIG2 #32, #38, #46.
said geographically limited list of retailers	Page 8 lines 25-26; 9 lines 24-26; FIG. 1 #14; and FIG 2 #38 # 40.
based on a postal code provided by said consumer	Page 9 lines 20-24; and FIG. 2 #32, #34, #36.
to said cooperative network site	Page 9 lines 24-26; and FIG 2 #34, #36.
via said manufacturer network site”	Page 9 lines 26-27; and FIG. 1 #10; and FIG 2 #10, #34.

10. Sixth Assertion

<b>Office Action at page 4 lines 9-17 alleges no original disclosure of:</b>	<b>Original disclosure of the recited limitations:</b>
“transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site,	FIG. 1 #12, #14, #16; FIG. 3; page 8 lines 18-19; and page 9 lines 3-14.

in response to a query from said consumer made over said communication network from said retailer network site;	FIG. 1 #12; FIG. 3 # 58, #66; page 10 lines 5-7 and page 9 lines 3-7.
transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and	FIG. 1 #12; FIG 3 #62; page 9 lines 12-13; and page 10 lines 12-13 .
transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer networks site”	FIG. 1 #12, #14; FIG. 3 #66, #68; page 9 lines 12-14; page 10 lines 13-16; and page 13 lines 28-30.

11. Seventh Assertion

<b>Office Action at page 4 lines 17 to page 5 line 4 alleges no original disclosure of:</b>	<b>Original disclosure of the recited limitations:</b>
“transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site,	FIG. 1 #14, #16, #22; FIG. 3; page 8 lines 18-19; page 9 lines 3-11; page 11 lines 8-17; and page 13 lines 6-19.
in response to a query from said consumer made over said communication network from said retailer network site;	FIG. 1 #12; page 10 lines 5-9; and page 9 lines 3-7.
transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and	FIG 1, #12; FIG. 3 #62; page 9 lines 12-13; and page 10 lines 11-12.
transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer networks site”	FIG 1 #14; page 9 lines 12-14; and page 10 lines 13-16.

12. Eighth Assertion

<b>Office Action at page 5 lines 4-12 alleges no original disclosure of:</b>	<b>Original disclosure of the recited limitations:</b>
“transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site,	FIG. 1 #12, #14, #16; FIG. 3; FIG. 7 #120, #122; page 4 lines 25-27; page 5 lines 13-16, page 8 lines 18-19; page 9 lines 12-13; page 10 lines 11-16; and page 13 lines 20-24.
in response to a query from said consumer made over said communication network from said retailer network site;	FIG. 1 #12; FIG 3 #50; page 3 lines 27-29; page 9 lines 7-13; page 10 lines 6-8; and page 13 lines 25-30.
transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and	FIG. 1 #12; FIG 3 #62;; page 9 lines 12-13; and page 10 lines 12-13.
transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer networks site”	FIG. 1 #14; FIG. 3 #66; page 9 lines 13-14; page 9 lines 12-14; and page 13 lines 18-19.

13. Ninth Assertion

<b>Office Action at page 5 lines 13-16 alleges no original disclosure of:</b>	<b>Original disclosure of the recited limitations:</b>
“transmitting from said cooperative network site	Page 8 lines 22-24; page 9 lines 26-27; and FIG. 1 #14; FIG. 2 #14.
said geographically limited list of retailers	Page 9 lines 24-26; FIG 1 #10; and FIG 2 #36.
based on a postal code provided by said consumer	Page 9 lines 20-24; and FIG. 2 #32, #34, #36.
to said cooperative network site	Page 9 lines 24-26; FIG. 1 #14; and FIG 2 #14, #34, #36.
via said manufacturer network site”	Page 9 lines 26-27; FIG. 1 #10; FIG. 1 #10; and FIG 2 #34.

14. Tenth Assertion

<b>Office Action at page 5 line 17 to page 6 line 3 alleges no original disclosure of:</b>	<b>Original disclosure of the recited limitations:</b>
“transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site,	FIG. 1 #12, #14, #16; and page 8 lines 18-19; page 10 lines 11-16; and page 9 lines 3-14.
in response to a query from said consumer made over said communication network from said retailer network site;	page 3 lines 27-29; page 10 lines 6-12; FIG. 1 #12; FIG 3 #50, #54, #62; and page 9 lines 3-7.
transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and	FIG. 1 #12; FIG 3 # 62; page 9 lines 12-13; page 10 lines 11-12; and page 13 lines 25-29.
transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer networks site”	FIG. 1 #14; FIG 3 #66; page 4, lines 1-2; page 10 lines 15-16; page 9 lines 12-14; and page 13 lines 18-19.

15. Eleventh Assertion

<b>Office Action at page 6 lines 3-12 alleges no original disclosure of:</b>	<b>Original disclosure of the recited limitations:</b>
“transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site,	FIG. 1 #14, #16; 22; FIG. 3; page 9 lines 3-11; page 11 lines 8-17; and page 13 lines 6-19.
in response to a query from said consumer made over said communication network from said retailer network site;	FIG. 1 #12; FIG. 3 #50, #54, #62; page 10 lines 5-16; page 13 lines 8-12; and page 9 lines 11-14.
transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and	FIG 1 #12; FIG 3 #62; page 9 lines 11-13; page and 10 lines 12-13.

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer networks site"	FIG 1 #14; FIG. 3 #66; page 4 lines 1-2; page 10 lines 15-16; page 9 lines 12-14; and page 13 lines 18-19.
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## 16. Twelfth Assertion

Office Action at page 6 lines 12-21 alleges no original disclosure of:	Original disclosure of the recited limitations:
"transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site,	FIG. 1 #14; FIG. 1 #16; FIG. 3; FIG. 7 #120, #122, #134; page 8 lines 18-19; page 9 lines 12-13; page 12 lines 6-20; page 13 lines 20-24; and page 14 lines 1-14.
in response to a query from said consumer made over said communication network from said retailer network site;	FIG. 1 #12; FIG. 3 #54, #56, #58; page 9 lines 7-13; page 10 lines 5-11; and page 13 lines 25-30.
transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and	FIG 1 #12; FIG. 3 #62; page 9 lines 12-13; and page 10 lines 12-13.
transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer networks site"	FIG. 1 #14; FIG. 3 #66; page 4 lines 1-2; page 10 lines 15-16; page 9 lines 11-14; and page 13 lines 18-19.

17. I swear under penalty of perjury that the foregoing is true and correct.

12/4/2002  
DATE

Michael C. Scroggie  
MICHAEL C. SCROGGIE

Printed: December 4, 2002 (2:47PM) ~~December 4, 2002 (1:18PM)~~

### **APPENDIX III - THE RELATED PROCEEDINGS**

ran

date/time code: August 22, 2008 (4:18pm)

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7/30/04  
 [JointAppendix.pdf] [Stamped\_CAT-34-SCRO-US\_050205.pdf]

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 51

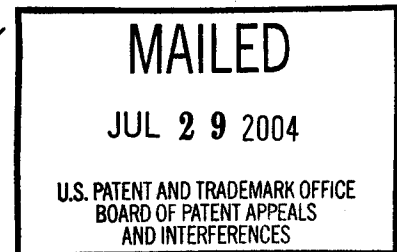
UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_ Action Re Dec. on App.  
 BEFORE THE BOARD OF PATENT APPEALS  
 AND INTERFERENCES  
 8-604

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,  
 DAVID W. BANKER and WILL GARDENSWARTZ

\_\_\_\_\_ CAT/34-SCRO-US  
 Appeal No. 2004-1267 ✓  
 Application No. 08/873,974 ✓

\_\_\_\_\_ ON BRIEF  
 \_\_\_\_\_



Before KRASS, FLEMING and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the rejection of twice-rejected claims 50-89.

The invention is directed to a system, process and computer program product for distributing product incentives to consumers over a communication network.

Dec App- CAT34SCROUS-040730 re SCROGGIE  
 Appeal No. 05-1164  
 000483

Appeal No. 2004-1267  
Application No. 08/873,974

Representative independent claim 50 is reproduced as follows:

50. A system for distributing product incentives to consumers over a communication network, comprising:

a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer;

at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network; and

a consumer computer coupled to one of said manufacturer network site and retailer network site via said communication network,

wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

The examiner relies on the following references:

Sloane	5,918,211	Jun. 29, 1999
		(filed May 30, 1996)

Narasimhan et al. (Narasimhan)	6,237,145	May 22, 2001
		(filed Aug. 14, 1996)

Claims 50, 51, 60, 61, 70, 71, 80 and 81 stand rejected under 35 U.S.C. § 102(e) as anticipated by Sloane.

—  
Appeal No. 2004-1267  
Application No. 08/873,974

Claims 52-59, 62-69, 72-79 and 82-89 stand rejected under 35 U.S.C. § 103 as unpatentable over Sloane in view of Narasimhan.<sup>1</sup>

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note that while appellants devote eleven pages in the Third Supplemental Brief, filed December 23, 2002, to arguing a rejection under 35 U.S.C. § 112, first paragraph, there is no such rejection on appeal herein since the examiner has made no such rejection in the answer. Accordingly, we consider only the prior art rejections under 35 U.S.C. § 102(e) and § 103.

Independent claims 50, 60, 70 and 80 all stand rejected as being anticipated by Sloane.

Taking claim 50, as exemplary, the examiner applies Sloane as follows:

---

<sup>1</sup>While claim 54 is included in the statement of rejection under 35 U.S.C. § 103, at page 5 of the answer, we note that the examiner includes this claim in the rejection under 35 U.S.C. § 102(e) in the explanation of the issues at page 2 of the answer. We will assume that the rejection of this claim is, in fact, under 35 U.S.C. § 103, as that is what the statement of rejection indicates.

Appeal No. 2004-1267  
Application No. 08/873,974

The "cooperative network site..." is said to be taught at column 7, lines 22-26, of Sloane. The "at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network" is said to be taught by Sloane at column 7, lines 13-17. The "consumer computer..." is said to be taught by Sloane at Figures 4 and 5, where the consumer computer is represented as the portable bar code scanning device. Finally, the wherein clause, "wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request..." is said to be taught by Sloane at column 7, line 65 through column 8, lines 7, and at column 8, lines 44-48.

Appellants' response to this rejection appears in the Supplemental Appeal Brief, filed April 11, 2001.

Appellants argue that whereas the instant invention is directed to distributing product incentives to consumers over a communication network, including a consumer computer coupled to various network sites, Sloane is concerned with providing incentives to consumers at a point-of-purchase in a retail store.

Appeal No. 2004-1267  
Application No. 08/873,974

We do not find this argument to be persuasive. Clearly, the network over which the sender, or manufacturer, sends the incentives to the retailer is a "communication" network. While even appellants admit that the processing of incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 is performed over a "communication" network (see Supplemental Appeal Brief of April 11, 2001-page 8), appellants argue that Sloane fails to disclose or suggest distributing product incentives to consumers over a communication network.

Again, we are not persuaded by this argument. While appellants may envision sending the incentives directly to consumers at their home computers, in this regard, the claims require only that there is a "consumer computer" coupled to one of the retailer or manufacturer network sites and that the incentives are transmitted to the consumer over the communication network and in response to a consumer request made over the network. It is our view that Sloane clearly teaches as much. As the examiner indicates, at page 4 of the answer, the "consumer computer" in Sloane may be the hand-held scanning device which the consumer carries through the store.

Appeal No. 2004-1267  
Application No. 08/873,974

First, we have already established that the transmissions in Sloane are performed over a "communication network."

Further, in Sloane, a sender of promotional information sends the information to the retailer computer/controller (column 7, lines 13-14). Thus, incentives are provided over a communication network. Then, the consumer is eventually given the promotion, or promotional price, on a given product through a wireless communication network, as the scanner (i.e., "consumer computer") offers the consumer the discount or promotion (note column 8, lines 1-7)<sup>2</sup>.

While one might argue that the promotion is not transmitted directly to the consumer computer in Sloane, the promotion is clearly transmitted, at least *indirectly*, to the consumer, and this is all that is required by the instant claims. Moreover, any promotion or discount offered in Sloane is clearly "in response to a consumer request." Not only does Sloane indicate in the Background section that it was known for consumers to

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<sup>2</sup>We note, further, the disclosure of Sloane, in the background section of the document, at column 2, lines 19-20, wherein it is disclosed that there were well known methods of issuing electronic coupons to consumers or promotions to consumers which include "consumer requested promotion/coupons through the use of their home computer and an online computer network."

—  
Appeal No. 2004-1267  
Application No. 08/873,974

request coupons over the internet, even in Sloane's actual invention, a consumer first locates and scans a related product required for a promotion and then the discount is taken (see column 8, lines 45-49).

Having determined that the examiner has set forth a prima facie case of anticipation and that appellants have failed to overcome such case by any convincing argument, we will sustain the rejection of claims 50, 51, 60, 61, 70, 71, 80 and 81 under 35 U.S.C. § 102(e).

Turning now to the rejection of claims 52-59, 62-69, 72-79 and 82-89 under 35 U.S.C. § 103, the examiner cites Narasimhan (specifically, column 4, lines 62-65, and column 8, lines 4-13) as providing for the deficiency, in Sloane, of disclosing, as in claim 52, for example, "wherein, in response to a query from said consumer made over said communication network from said manufacturer network site, said cooperative network site transmits a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer...."

It is the examiner's position that it would have been obvious to provide such a list of geographically limited retailers so as to give the consumer "the ability to customize

Appeal No. 2004-1267  
Application No. 08/873,974

and control his or her purchase preferences by location" (answer-page 5).

Appellants' Supplemental Appeal Brief, filed April 11, 2001, says nothing about this rejection based on Narasimhan, referring only to a rejection based on a patent to Allsop, together with Sloane. Similarly, neither appellants' Appeal Brief, filed March 2, 2001, nor the Third Supplemental Brief, filed December 23, 2002, says anything about this rejection. Accordingly, nothing therein is persuasive of any error on the examiner's part in rejecting the claims under 35 U.S.C. § 103 over Sloane and Narasimhan.

In fact, we have nothing responsive to the examiner's specific rejection under 35 U.S.C. § 103 until the Reply Brief, filed April 22, 2003, at which point appellants present no argument regarding the merits of the examiner's rejection, preferring, instead, to attack the examiner's rejection under 35 U.S.C. § 103, based on the combination of Sloane and Narasimhan, by attacking it procedurally. More particularly, appellants argue that this constitutes a new ground of rejection which is prohibited by 37 CFR 1.193 (a)(2).

We have reviewed the record of this case and it appears that the rejection under 35 U.S.C. § 103, based on Sloane and

Appeal No. 2004-1267  
Application No. 08/873,974

Narasimhan, is not a new ground of rejection as to claims 52, 53, 55-59, 62, 72 and 82, the rejection in the Answer appearing substantially the same as a rejection of those claims in Paper No. 45 (page 9), mailed September 23, 2002.

However, the rejection of claims 54, 63-69, 73-79 and 83-89 under 35 U.S.C. § 103, appearing in the answer, does constitute a new ground of rejection because the rejection of these claims on this ground does not appear in Paper No. 45.

Accordingly, we will summarily sustain the rejection of claims 52, 53, 55-59, 62, 72 and 82 under 35 U.S.C. § 103 because the examiner seems to have stated a reasonable case for a finding of obviousness, which has not been rebutted by appellants in any substantive manner. We note, however, that our affirmance of this rejection is pro forma, and not based on substantive arguments since appellants have presented no substantive arguments with regard to this rejection.

With regard to the rejection of claims 54, 63-69, 73-79 and 83-89 under 35 U.S.C. § 103, this is a new ground of rejection, not permitted under 37 CFR 1.193 (a) (2). Accordingly, with regard to the rejection of these claims, we remand the application to the examiner to either withdraw the rejection or reopen prosecution, giving appellants an opportunity to respond

—  
Appeal No. 2004-1267  
Application No. 08/873,974

to the new ground of rejection if it is to be applied.

Since we have sustained the rejection of claims 50, 51, 60, 61, 70, 71, 80 and 81 under 35 U.S.C. § 102(e) and the rejection of claims 52, 53, 55-59, 62, 72, and 82 under 35 U.S.C. § 103, the examiner's decision is affirmed.

The application is also remanded to the examiner for action consistent with the reasoning herein with regard to the rejection of claims 54, 63-69, 73-79 and 83-89 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

Appeal No. 2004-1267  
Application No. 08/873,974

This application, by virtue of its "Special" status, requires an immediate action, MPEP 708.01 (8th ed., August, 2001).

AFFIRMED AND REMANDED

Encl. 11

ERROL A. KRASS  
Administrative Patent Judge

*Michael R. Fleming*  
MICHAEL R. FLEMING

MICHAEL R. FLEMING ( )  
Administrative Patent Judge ( )

JOSEPH L. DIXON

JOSEPH L. DIXON /  
Administrative Patent Judge )

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

EK/RWK

Appeal No. 2004-1267  
Application No. 08/873,974

NEIFELD IP LAW, PC  
2001 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

10-704  
[JointAppendix.pdf]esStamped\_CAT-34-SCRO-US\_050205.pdf]

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 53

UNITED STATES PATENT AND TRADEMARK OFFICE

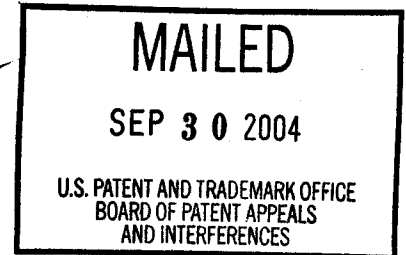
Atty Review: 10-704

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,  
DAVID W. BANKER and WILL GARDENSWARTZ

Appeal No. 2004-1267 ✓  
Application No. 08/873,974 ✓

ON BRIEF



Before KRASS, FLEMING and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request rehearing of our decision of July 29, 2004, wherein we affirmed the examiner's decision rejecting claims 52, 53, 55-59, 62, 72 and 82 under 35 U.S.C. § 103.

Initially, appellants argue that we have not decided an issue involving a rejection under 35 U.S.C. § 112, even though that rejection had been withdrawn by the examiner and was not on

Appeal No. 2004-1267  
Application No. 08/873,974

appeal before us. Appellants take the position that the rejection was, in fact, on appeal because they had appealed from the examiner's rejection of the claims under 35 U.S.C. § 112 and that we must decide the propriety of this rejection even in the face of the examiner's withdrawal of such rejection.

We disagree. Once an examiner withdraws a rejection of claims, at or before the time of the answer, that rejection is no longer before us on appeal and we will not issue an opinion as to the propriety of a now-theoretical rejection.

Appellants are concerned that since there was a suggestion of reopening prosecution in our decision<sup>1</sup>, a lack of a decision by us regarding the § 112 rejection might leave appellants open to re-imposition of that rejection by the examiner.

If, and when, the examiner deems it appropriate to make a rejection under 35 U.S.C. § 112, and such rejection is appealed to us, we will treat that rejection. But, at least at the time of the answer, the examiner no longer believed a rejection under 35 U.S.C. § 112 to be proper and chose not to make it. The Board would find itself in an awkward position attempting to decide an

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<sup>1</sup>We indicated in the decision, at page 9, that the examiner's rejection of claims 54, 63-69, 73-79, and 83-89 under 35 U.S.C. § 103 was a new ground of rejection, not permitted under 37 CFR 1.193 (a)(2), and remanded to the examiner to either withdraw the rejection or reopen prosecution.

Appeal No. 2004-1267  
Application No. 08/873,974

issue on which both appellants and the examiner are in apparent agreement, viz., that a rejection under 35 U.S.C. § 112 was not improper. Where there is no controversy, there is no need for the Board, or any tribunal, to make a decision.

Accordingly, we decline appellants' invitation to render a decision on whether claims are proper, within the meaning of 35 U.S.C. § 112.

Appellants further argue that we misapprehended the claim limitation, "in response to a consumer request..." and the reasoning in support thereof in the brief filed July 10, 2001.

Part of the problem arises from multiple filings, by appellants, of various briefs and supplemental briefs, and attempting to incorporate by reference, into the arguments, all of these briefs. Thus, rather than including all of appellants' arguments in a single brief and/or a brief and possibly one reply brief, the record is rife with arguments scattered throughout several papers.

In any event, our decision did treat the "in response to a consumer request..." limitation of the claims, by indicating, at page 6 of our decision, that any promotion or discount offered in Sloane is clearly "in response to a consumer request." The reason is explained in the paragraph bridging pages 6-7 of the

Appeal No. 2004-1267  
Application No. 08/873,974

decision. Thereat, we indicated that the background section of Sloane disclosed that it was known for consumers to request coupons over the internet (see column 2, lines 18-21). Further, we noted, at page 7 of the decision, that even in Sloane's actual invention, a consumer first locates and scans a related product required for a promotion (see column 8, lines 45-49). Accordingly, it is clear that any promotion, or discount, issued is "in response to a consumer request..." as claimed.

Thus, it is clear that, contrary to appellants' assertions, we did not ignore the "in response to a consumer request..." limitation of the claims.

Appellants further argue that we overlooked the brief filed July 10, 2001 and the reasoning therein relative to the inapplicability of the Narasimhan reference. We have reviewed the second supplemental brief, filed July 10, 2001, but find nothing therein to cause us to modify our decision. In that document, appellants simply point out that "there is no evidence supporting the examiner's rationale that transmitting a geographically limited list of retailers honoring incentives in response to a query is a more efficient way of obtaining desired information;" and that the examiner's conclusion of obviousness in combining the teachings of Narasimhan and Sloane "is vague" and "unsupported" by any evidence.

Appeal No. 2004-1267  
Application No. 08/873,974

We find appellants' arguments insufficient to overcome the examiner's reasonable explanation that Narasimhan suggests, at column 4, lines 62-65, and column 8, lines 4-13, providing for certain geographic-specific promotions to consumers. Again, appellants do not appear to have addressed the specific teachings of Narasimhan, as pointed out by the examiner. Appellants' mere assertion that there is no evidence supporting the examiner's rationale, or that the examiner's conclusions are "vague," fails to point out the error in the examiner's position that Narasimhan clearly suggests using geographic-specific promotions.

Having responded to each and every assertion made by appellants in the Request for Rehearing, filed August 6, 2004, and finding nothing persuasive therein, we decline to make any modification to our decision of July 29, 2004. Appellants' request for rehearing is granted to the extent that we have reviewed and reconsidered our decision and the evidence of record, but the request is denied with respect to making any changes therein.

Appeal No. 2004-1267  
Application No. 08/873,974

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

Ernest A. Kr...

ERROL A. KRASS  
Administrative Patent Judge

Mr. R. F. [Signature]

MICHAEL R. FLEMING  
Administrative Patent Judge

*[Handwritten signature]*  
JOHN L. DIXON

JOSEPH L. DIXON  
Administrative Patent Judge

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—  
Appeal No. 2004-1267  
Application No. 08/873,974

NEIFELD IP LAW, PC  
2001 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

DHS  
2/4/08

ATTACHMENT 3



# UNITED STATES PATENT AND TRADEMARK OFFICE

RAN: Attorney review Decision on Appeal: 2/7/08  
RAN: Post appeal action, if any: 2/28/08  
KSP: 1 year no action PTO status check 2/4/09 (MODIFIED)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/873,974	06/12/1997	MICHAEL C. SCROGGIE	CAT/34-SCRO-US	2461
31518	7590	01/31/2008		
NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304			EXAMINER ROBINSON BOYCE, AKIBA K	
			ART UNIT 3628	PAPER NUMBER
			NOTIFICATION DATE 01/31/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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rneifeld@neifeld.com  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL C. SCROGGIE, DAVID A. ROCHON,  
DAVID W. BANKER, and WILL GARDENSWARTZ

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Appeal 2006-2100  
Application 08/873,974  
Technology Center 3600

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Decided: January 29, 2008

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Before JOSEPH F. RUGGIERO, HOWARD B. BLANKENSHIP, and  
DAVID B. WALKER, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal from the Examiner's rejection of claims 50-89,  
which are all the claims remaining in the application. We have jurisdiction  
under 35 U.S.C. §§ 6(b), 134(a).

We reverse. ✓

*I. The Invention*

Appellants' invention relates to systems for delivering incentives and related information to consumers via a computer network that links the consumers to network sites provided by product retailers and by manufacturers. (Spec. 1: 6-10.) Claim 50 is illustrative:

50. A system for distributing product incentives to consumers over a communication network, comprising:

a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer;

at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network; and

a consumer computer coupled to one of said manufacturer network site and retailer network site via said communication network,

wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

*II. The References*

The Examiner relies on the following references as evidence of unpatentability:

Sloane

US 5,918,211

Jun. 29, 1999  
(filed May 30, 1996)

Narasimhan                      US 6,237,145 B1

May 22, 2001  
(filed Aug. 14, 1996)

### *III. Procedural Background*

In a decision by the Board mailed July 29, 2004, the Board reviewed the Examiner's rejection of claims 50, 51, 60, 61, 70, 71, 80, and 81 under 35 U.S.C. § 102(e) as being anticipated by Sloane, and the rejection of claims 52-59, 62-69, 72-79, and 82-89 under 35 U.S.C. § 103 as being unpatentable over Sloane in view of Narasimhan. The rejection of the claims under 35 U.S.C. § 102(e) was affirmed. The rejection of claims 52, 53, 55-59, 62, 72, and 82 under 35 U.S.C. § 103 was affirmed, *pro forma*, because no substantive arguments on Appellants' part were found in response to the rejection. Although there were affirmed rejections, the proceeding was remanded to the Examiner to either withdraw the rejection of claims 54, 63-69, 73-79, and 83-89 under 35 U.S.C. § 103, or reopen prosecution, because the rejection was found to be an improper new ground of rejection.

In a decision on Request for Rehearing (mailed Sep. 30, 2004), the Board noted the difficulty in determining the arguments that had been presented in opposition to the rejections, as Appellants had filed various briefs, and supplemental briefs, which attempted to incorporate by reference earlier briefs. The Request was denied to the extent of making any modification in the earlier decision of July 29, 2004.

Appellants filed an appeal to the U.S. Court of Appeals for the Federal Circuit on November 23, 2004. The Court remanded the case to the USPTO (Mar. 9, 2005) upon consideration of Appellants' unopposed motion. The Board's decision was not a final decision ripe for judicial review. *See* 37 C.F.R. § 41.50 (e) (effective Sep. 13, 2004) ("Whenever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.").

In due course, the Examiner mailed a non-final rejection (Jul. 12, 2005) that set forth a rejection of claims 63, 73, and 83 under 35 U.S.C. § 103(a) as being unpatentable over Sloane, and a rejection of claims 54, 64-69, 74-79, and 84-89 under 35 U.S.C. § 103(a) as being unpatentable over Sloane and Narasimhan.

Appellants in response filed the Appeal Brief<sup>1</sup> (Dec. 12, 2005; styled as a reply brief), to which the Examiner responded in turn by the (most recent) Examiner's Answer mailed March 13, 2006. Finally, Appellants filed the Reply Brief in response, on March 17, 2006.

The Examiner, in the most recent Answer, repeats the rejections set forth in the Non-Final rejection of July 12, 2005. In the Examiner's view, the instant appeal does not involve claims 50-53, 60-62, 70-72, and 80-82, as

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<sup>1</sup> Appellants submit that we should review an earlier rejection under 35 U.S.C. § 112, first paragraph, that was withdrawn by the Examiner and is thus not before us. We decline, as did the earlier Board panel, to review a rejection that no longer exists and which represents no current controversy.

the rejection of those claims was earlier sustained by the Board. The rejections are not repeated in the most recent Answer.

*IV. Representative Claims 50, 54*

Claim 54, rejected under 35 U.S.C. § 103(a) as being unpatentable over Sloane and Narasimhan, depends from claim 50. To understand claim 54 thus requires that we understand the limitations of the base claim that claim 54 incorporates by reference. Our review of the rejection of claim 54 also requires that we understand the rejection applied against claim 50 (as being anticipated by Sloane), since claim 54 is rejected over the combined teachings of Sloane and Narasimhan.

Appellants have presented arguments in the Appeal Brief that convince us of error in the rejection applied against representative claim 54, and against all the independent claims rejected under § 102(e) over Sloane. We would normally not re-visit a decision by an earlier panel of the Board. We will do so, however, in view of the particular circumstances of this case. First, as we have noted, we must understand the rejection applied against claim 50 to understand the rejection applied against claim 54. Further, as the earlier panel noted, the arguments presented to that panel were difficult to ascertain because of the multiple briefs and the arguments scattered throughout.<sup>2</sup> Still further, we are not reversing the decision of the earlier

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<sup>2</sup> Appellants' current Appeal Brief does not purport to incorporate other papers by reference, nor should it. *See* 37 C.F.R. § 41.37 ("Any arguments or authorities not included in the brief or a reply brief filed pursuant to

panel because, as we have noted, the decision was not a final decision of the Board. The Board was free to reconsider the decision in the event that the application returned to the Board's jurisdiction. Finally, the record before this panel has been supplemented by Appellants' current briefs, and thus constitutes a record different from that upon which the earlier panel based its determinations. If the case had been returned to the earlier panel, that panel might well have decided that the record then before the panel required that the earlier-affirmed rejections be reconsidered.

*V. Section 102 rejection over Sloane*

The Examiner applies a rejection against all the independent claims (50, 60, 70, and 80) under 35 U.S.C. § 102(e) as being anticipated by Sloane at pages 7 and 8 of the Non-Final Rejection mailed September 23, 2002, repeated at pages 3 and 4 of the Answer mailed March 11, 2003 ("03 Answer").

Sloane describes a system in which a consumer receives a portable bar code scanner (20; Fig. 2a) when entering a retail establishment. Sloane col. 5, ll. 29-51. When the consumer scans a product, display 34 (Fig. 2a) will show the product's price, in addition to showing any promotional information available for that product or a related product. Col. 6, ll. 20-25. The bar code scanner 20, in conjunction with retailer computer/controller 12 (e.g., Figs. 5 and 6), will, *inter alia*, maintain a running total of the

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§ 41.41 will be refused consideration by the Board, unless good cause is shown.").

purchases made by the user, and enable the user to view the current savings on the shopping trip. Col. 6, l. 64 - col. 7, l. 3.

As set forth in the '03 Answer (at 4), the Examiner finds that the retailer computer/controller of Sloane is “analogous to” the cooperative network site and the sender (16; Fig. 3b) of Sloane is “analogous to” the manufacturer. The Examiner reads the claimed “consumer computer” on the portable bar code scanning device of Sloane. The “wherein” clause of claim 50 is deemed to be met by the description at column 7, line 65 through column 8, line 7, and at column 8, lines 44 through 48.

Claim 50 recites, *inter alia*, wherein “said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request *made over said communication network from one of said manufacturer network site and retailer network site*” (emphasis added). The statement of the rejection ('03 Answer 4) ends with “in response to a consumer request...,” and does not indicate how the rest of claim 50 might be met by Sloane.

However, the '03 Answer appears to offer an explanation of how the language is met, in the “Response to Argument” section.

[T]he cooperative network site is represented in Col. 7, lines 15-22 by the on-line computer network (LAN OR WAN). This computer network acts as the cooperative network site since this addition allows the manufacturer computer system to communicate with the retailer computer system. Also, Sloane shows that a consumer request can be incorporated into the system in Col. 2, lines 17-21. In this case, the consumer

requests a promotion/coupon through an on-line computer network. Also col. 7, lines 4-15 show that when a consumer selects an item (analogous to the consumer request), the sender of the promotional information sends the information to the retailer computer. In this case, the consumer's request triggers the transmittal of the promotional information from the manufacturer's system to the retailer's system.

('03 Answer 11-12.)

Sloane provides:

Other methods of issuing electronic coupons or promotions to the consumer's frequent shopper electronic account includes consumer requested promotion/coupons through the use of their home computer and an online computer network, such as, for example, the internet.

Sloane col. 2, ll. 17-21.

The text at column 2, lines 17 through 21 of Sloane might show that a consumer request "can be" incorporated into the inventive system of Sloane, but that seems to relate to an inquiry into obviousness. The rejection, however, is under § 102 for anticipation. The "other methods" described by Sloane in column 2 are in the context of describing the prior art in relation to Sloane; i.e., the text at column 1, line 15 through column 2, line 49 describes "The Prior Art."

Sloane further provides:

FIG. 3a shows the first step of the method according to the invention. A retailer 14 designates items that are on sale, or offered with some other consumer promotion or message, and instructs the retailer computer/controller 12 to offer these promotions to the consumer when one of the subject items or

related items are selected (i.e., scanned) by the consumer. FIG. 3b shows an alternative first step to the method where the sender of promotion information 16 can be someone other than the retailer, such as, for example, the product manufacturer. The sender of promotion information 16 sends the information to the retailer computer/controller 12 via communication line 200.

Sloane col. 7, ll. 4-15.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

We do not find any support in Sloane for the Examiner’s finding that the sender of the promotional information sends the information to the retailer computer when the consumer selects an item, or that the consumer’s request triggers the transmittal of the promotional information from the manufacturer’s system (16; Fig. 3b) to the retailer’s system. For example, Sloane’s drawings indicate information transfer between the portable bar code scanning device and the retailer computer/controller 12 (e.g., Figs. 5 and 6), which is separate from the reception by the retailer computer of promotion information by sender 16 (Fig. 3b). “Retailer computer/controller 12 is programmed to receive and store the promotional information sent by

retailer 14 or sender 16, and can therefore offer the promotions at the appropriate time and to the appropriate consumer.” Sloane col. 7, ll. 22-26.

Nor do we find that Sloane inherently describes the material that the rejection attributes to the reference.

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

*In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted). In Sloane, information is *not necessarily* transmitted to the consumer in response to a consumer request made over the communication network from the retailer network site, because retailer computer/controller 12 can already possess the information received from sender (or manufacturer) 16 when the consumer selects an item, consistent with the express disclosure.

#### *VI. The Rejections*

For the foregoing reasons in Section V, Sloane fails to provide sufficient support for the Examiner’s finding of anticipation with respect to independent claim 50. Each of the other independent claims (60, 70, and 80), rejected under § 102(e) over Sloane, contains substantially the same limitations of claim 50 that we consider to be not met by the reference. Because the remaining rejections do not remedy the basic deficiency in the

rejection applied against the independent claims, we cannot sustain any rejection on appeal.

### CONCLUSION

The Examiner's rejections of claims 50-89 over the applied prior art are reversed.

REVERSED

pgc

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ALEXANDRIA VA 22304

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

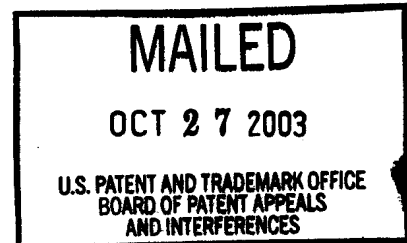
REVIEW DATE: 11/27/03

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,  
DAVID W. BANKER and WILL GARDENSWARTZ

Appeal No. 2002-0329  
Application No. 09/505,632

ON BRIEF



Before KRASS, JERRY SMITH and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 24-31, 34, 36-43, 46, 48 and 49.

The invention maintains a database of manufacturer offers and retailer special deals at a cooperative network site where consumers can access at least a subset of the data in the database from any manufacturer or retailer network site.

APDEC-CAT34SCROCCP-031103 CS

Accordingly, it makes little difference which site, whether manufacturer or retailer, that the consumer is logged in to when initiating the request since the data is received directly from the cooperative site. The result is that manufacturer offers and retailer special deals are exposed to many more consumers.

Representative independent claim 24 is reproduced as follows:

24. A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

The examiner relies on the following references:

Smolen	5,915,243	Jun. 22, 1999 (filed Aug. 29, 1996)
Sloane	5,918,211	Jun. 29, 1999 (filed May 30, 1996)

Appeal No. 2002-0329  
Application No. 09/505,632

Hoffman et al. (Hoffman)                      6,012,039                      Jan. 4, 2000  
(effectively filed Aug. 29, 1996)

Claims 28, 34, 40 and 46 stand rejected under 35 U.S.C.  
§ 102(e) as anticipated by Sloane.

Claims 24-27, 29-31, 36-39, 41-43, 48 and 49 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites Sloane and Hoffman with regard to claims 24, 25, 27, 29, 36, 37, 39, 41, 48 and 49, adding Smolen to this combination with regard to claims 26, 30, 31, 38, 42 and 43.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

#### OPINION

Turning, initially, to the rejection under 35 U.S.C. § 102(e), an anticipatory reference is one which describes all of the elements of the claimed invention so as to have placed a person of ordinary skill in the art in possession thereof. In re Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990).

It is the examiner's position that Sloane discloses, at column 7, lines 5-10, the transmission from a consumer computer of a request for manufacturer incentives; at column 7, lines 13-

22, the transmission of region data from the website of a manufacturer in response to the request for manufacturer incentives; at column 7, lines 22-26, transmission from a remote website to the manufacturer website at least one manufacturer incentive and at least one name and address of a retailer in response to receipt of region data at the manufacturer's website; and, at column 7, lines 36-40, updating a manufacturer's incentive database.

The examiner also cites column 8, lines 3-7, of Sloane as part of the rationale for the rejection.

The examiner contends that it is inherent to include graphical image data corresponding to manufacturer incentives because Sloane does disclose that his communication line can be an online computer network or the Internet (column 7, lines 18-22) -See answer-page 4.

It is appellants' view that although Sloane does disclose processing incentives between a retailer, or product manufacturer, and a retailer computer/controller 12 over a communication network 200, Sloane does not disclose or suggest distributing product incentives to consumers over the internet (principal brief-page 7). Furthermore, argue appellants, "the communication sequence defined by the present invention is

clearly a request-response transaction involving three distinct entities, namely, a consumer computer, a manufacturer website, and a remote website, using a request-response communication protocol" (reply brief-page 2).

We agree with appellants that the subject matter of independent claims 28 and 40 is not anticipated by Sloane. These claims clearly call for a transaction involving multiple separate entities, i.e., transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives.

In Sloane, there is no middle-man communication. Incentives are communicated to the consumer by either the retailer or another sender of information, e.g., the manufacturer. There is no transmission from a retailer website to a remote website in response to an inquiry from a consumer to the retailer website. The examiner identifies Figure 3b of Sloane, indicating that the sender of promotion information, 16, is indicative of a "remote website."

Appeal No. 2002-0329  
Application No. 09/505,632

The sender of promotion information 16 in Sloane is, indeed, sent from a remote site, e.g., the manufacturer. However, this information is communicated as an alternative to the retailer supplying incentive information. Moreover, this remote site 16 in Sloane, does not provide information "in response to receipt of said request at said Web site of said retailer," as required by the claims.

Accordingly, we will not sustain the rejection of claims 28 and 40 under 35 U.S.C. § 102(e).

With regard to claims 34 and 46, these claims are a bit broader in scope. They do not recite the separate communications of claims 28 and 40. In fact, claims 34 and 46 merely require a transmission from a manufacturer to a remote Web site regarding manufacturer incentive data, and then updating the manufacturer's incentives database, including graphical image data corresponding to the manufacturer's incentives.

Sloane clearly teaches, in Figure 3b, communicating manufacturer incentive data from the manufacturer to a remote Web site. The sender of promotional information, 16, may be a manufacturer (column 7, lines 11-13) and the information is sent to the consumer, at the retail computer 12, the retail computer 12 being remote from the manufacturer.

Clearly, the information in Sloane is sent over the internet (column 7, line 22). When the manufacturer transmits this information to computer/controller 12, the information is clearly an "update" of the manufacturer's incentives database. The examiner calls this feature "inherent" and we would agree.

The only limitation of claims 34 and 46 not explicitly, or implicitly, disclosed by Sloane is "graphical image data corresponding to said manufacturers incentives." The examiner calls this a "traditional practice to present data using a graphical user interface which presents graphical image data" (answer-page 4), and holding such a disclosure in Sloane to be inherent.

Appellants' position is that Sloane does not disclose updating a manufacturers incentives database storing data defining manufacturers incentives including graphical image data corresponding to the manufacturers incentives with the manufacturer incentive data (principal brief-page 10). While it may be "traditional" to present data using a graphical user interface which presents graphical image data over the internet, "this in-and-of-itself does not teach nor suggest storing data defining manufacturers incentives including graphical image data

corresponding to the manufacturers incentives, as in the claimed invention" (principal brief-page 10).

Since appellants do not deny that it is "traditional" to present data using a graphical user interface which presents graphical image data over the internet and Sloane clearly discloses storage of data defining manufacturers incentives by updating such information in a remote site via the internet, we will sustain the examiner's rejection under 35 U.S.C. § 102(e) since the consumer using the retailer computer/controller will be using a graphical user interface (GUI) to interface with the incentives information stored therein.

While we have sustained the rejection of claims 34 and 46 under 35 U.S.C. § 102(e), because appellants have not convinced us of error in the examiner's reasoning, it is our view that the rejection would have been stronger had it been made under 35 U.S.C. § 103 since, while not explicitly shown by Sloane, it would have been obvious for the consumer to interact with the retailer computer/controller via a GUI regarding the available manufacturers incentives. In any event, it would have been obvious to store the incentives "including graphical image data" since, as admitted by appellants, it is "traditional" to present data using a GUI.

Appeal No. 2002-0329  
Application No. 09/505,632

With regard to the rejections under 35 U.S.C. § 103, we will not sustain these rejections because each of the independent claims 24, 36, 48 and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives. As explained supra, Sloane is devoid of any such teaching. Moreover, neither Hoffman nor Smolen provides for this deficiency of Sloane. Accordingly, the examiner has not made out a prima facie case of obviousness with regard to the subject matter of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 and we will not sustain the rejection of these claims under 35 U.S.C. § 103.

#### CONCLUSION

We have sustained the rejection of claims 34 and 46 under 35 U.S.C. § 102(e) but we have not sustained the rejection of claims 28 and 40 under 35 U.S.C. § 102(e) or the rejection of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 under 35 U.S.C. § 103.

Appeal No. 2002-0329  
Application No. 09/505,632

Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

ERROL A. KRASS  
Administrative Patent Judge

*Jerry Smith*  
JERRY SMITH  
Administrative Patent Judge

*Joseph F. Ruggiero*  
JOSEPH F. RUGGIERO  
Administrative Patent Judge

BOARD OF PATENT  
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Appeal No. 2002-0329  
Application No. 09/505,632

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